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No. 2641.

IN THE
United States
Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

Wilson & Willard Manufacturing Com-
pany, et al.,

Appellants,

vs.

Robert E. Bole, et al.,

Appellees.

BRIEF FOR APPELLANTS.

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Solicitor and Counsel for Appellants.

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STATEMENT OF THE CASE.

This cause comes before this court on an appeal from an interlocutory decree entered against the appellants, defendants Wilson & Willard Manufacturing Company and Elihu C. Wilson, which interlocutory decree held that the Bole *et al.* patent No. 1,080,135 sued on was valid and infringed by the defendants by manufacture and sale to others to be used as under-reamers embodying, containing and embracing the invention de-

scribed, set forth and claimed in and by said letters patent No. 1,080,135. The defendants interposed the following principal defenses: first, that Bole, the patentee of said letters patent, was not the original, true and first or prior inventor of the subject of said letters patent, but that the defendant Wilson was the original, sole and first or prior inventor of the subject of said letters patent; second, that said Bole obtained said letters patent surreptitiously and unjustly for what was in fact the invention of said Wilson, who was using due diligence in adapting, perfecting and utilizing the same, and who, in fact, applied for letters patent for said subject of said letters patent sued under within one month after the time said Bole applied for said letters patent sued under, and that, upon an interference proceeding declared in the Patent Office pursuant to Sec. 4904 U. S. Revised Statutes, said Wilson had been found the first, original, true and sole inventor of the subject of said letters patent sued under; third, that the said Bole patent is void for anticipation, or want of novelty, in Bole, the under-reamers containing and embodying the invention therein described and claimed having been manufactured and sold by the defendants with the knowledge of the complainant Bole and without protest from him and with his tacit consent for a period of approximately twenty-two months before said Bole applied for said letters patent in suit; and, fourth, that said Bole is estopped from asserting any claim against these defendants in and about the subject of said letters patent, or from making any claim of right to said invention, by his own disavowal, dis-

claimer or covenant made or entered into within a month prior to the time when said Bole applied for said letters patent in suit.

The interlocutory decree made the usual further findings as prayed for in the bill, and the decree provided for the usual accounting and injunction, the latter directed against each of the said defendants, and ordered the usual taxation of costs against the defendants. The defendants assigned the following errors upon taking their appeal [pp. . . of the transcript]:

I. That the District Court of the United States for the Ninth Circuit, Southern District of California, Southern Division, erred in entering any decree in favor of complainants;

II. That said court erred in finding and decreeing that the letters patent sued on are good and valid in law;

III. That said court erred in finding and decreeing that the letters patent sued on, because good and valid in law, are infringed;

IV. That the court erred in finding and decreeing that Robert E. Bole was the original, first, true and sole inventor of the invention disclosed and claimed in and by the letters patent sued on;

V. That said court erred in not finding and decreeing that Elihu C. Wilson of the defendants was the original, first, true and sole inventor of the invention of the letters patent sued on;

VI. That said court erred in finding and decreeing that the letters patent sued on are not anticipated by the manufacture, sale and use of under-reamers manu-

factured and sold to others to be used by the defendants prior to the date of application of the letters patent sued on;

VII. That said court erred in finding and decreeing that the complainant, Robert E. Bole, did not surreptitiously or unjustly obtain the letters patent sued on for that which was in fact invented by another, viz.: Elihu C. Wilson of the defendants, who was using reasonable diligence in adapting and perfecting the same;

VIII. That said court erred in not holding and finding that the complainant, Robert E. Bole, was estopped from asserting any right in and about the invention of the patent sued on and from prosecuting any claim of infringement of said letters patent as against the defendants.

IX. That said court erred in finding that the defendant, Elihu C. Wilson, obtained the invention of the patent sued on from the complainant, Robert E. Bole.

X. That said court erred in receiving in evidence the deposition of Roy L. Heber as a witness on behalf of complainants;

XI. That said court erred in not following and adopting the decision of the United States Patent Office that the defendant, Elihu C. Wilson, and not the complainant, Robert E. Bole, is the original, true, first and sole inventor of the invention of the letters patent sued on;

XII. That said court erred in not admitting certain testimony offered or attempted to be taken on

behalf of defendants tending to further establish the defendant, Elihu C. Wilson, and not the complainant, Robert E. Bole, as the original, true, first and sole inventor of the invention of the letters patent sued on;

XIII. That said court erred in refusing to admit certain evidence offered by defendants to further prove that the defendant, Elihu C. Wilson, and not the complainant, Robert E. Bole, was the original, true, first and sole inventor of the invention of the patent sued on;

XIV. That said court erred in holding that the complainant, Robert E. Bole, was in any manner diligent in and about the invention of said letters patent sued on, if in fact in any manner possessed of the same prior to disclosure of the same to him by the defendant, Elihu C. Wilson;

XV. That said court erred in holding that the defendant, Elihu C. Wilson, was lacking in diligence or negligent as to reducing the invention to practice or applying for patent for same.

XVI. That said court erred in not holding and finding that the complainant, Robert E. Bole, obtained the invention of the patent sued on from the defendant, Elihu C. Wilson.

The opinion of the lower court was orally rendered, and was reported by one of the reporters who took the record of the proceedings in the case as follows:

The Court: In this case on trial I do not care to hear any further argument on the subject. I have carefully considered and am thoroughly convinced and do not need any further argument or evidence to con-

vince me that Bole invented this key and is justly entitled to a patent. If there had not been any patent issued in the case, or if the patent had been issued to the defendant, I should have decided this case in favor of Bole. There has been a good deal of criticism indulged in concerning some of these witnesses who have testified in favor of Bole, particularly Adams and Heber. I do not see any necessity for their being criticised. If a man wants to fix up evidence, it seems to me that he could fix up evidence more material than those witnesses were able to testify to. And in the same way in regard to this exhibit that has been introduced. If Mr. Bole was wanting to fix up evidence for the purpose of perjuring himself and to have other people perjure themselves, he would have gotten evidence that was more material. Of course, these are material in a way, but they are not in any sense controlling. Now, Mr. Bole has been criticised for not being industrious and active in his application for a patent. Nothing was done with this thing from the time he conceived it in his mind and suggested it to these witnesses till he apparently wrote a letter to Mr. Willard about it in 1911. He was not in the business of manufacturing reamers. He was not in a situation to put it into execution. According to the evidence, as I view it, he applied to his associates to put this key into use. Of course, until it was tried out, it would be nonsensical to apply for a patent. He had no opportunity to apply for a patent, associated as he was with Wilson and Willard, unless they would try it out. I think that entirely excuses his delay down to

1911, from the time this key was invented or put into practical use, until the patent was applied for. I think Wilson was as negligent as Bole in that regard. He was more interested in it, probably, if he were the inventor, than Bole was. He does not make any explanation why he waited nearly two years to apply for a patent. That letter that Bole wrote to Wilson when he got into the difficulty, it seems to me, is the most natural thing in the world for him to do. What it says we can all accept as absolute truth. That is to say, that he wrote the letter and made these claims. And what he claimed in the letter was the most natural thing for him to do if he was the inventor of this key. I think it was a very unnatural and unusual thing for Mr. Wilson to do, if he claimed to be the inventor of that thing, to make a settlement with Bole without including in that settlement the controversy concerning the key. It was very unbusinesslike and very unnatural. I have not the slightest doubt about how to decide this case and I will decide it in favor of complainants.

I.

Circumstances Surrounding the Trial of this Case.

This case was tried before the Honorable Oscar A. Trippet in March and April of this present year, but a very few days after his ascending the bench upon appointment to fill the vacancy caused by the resignation of former Judge Wellborn. It may, appellants contend, be affirmed, with all due propriety and respect,

that the court was almost entirely unfamiliar with the principles, doctrines and authorities pertinent to the determination of questions of patent law, having been previously engaged in the general practice of the law, and it is our recollection that the trial judge has admitted from the bench his practically entire unfamiliarity with the subject of patent law prior to his incumbency. This present case involved principles of patent law which, while possibly not particularly abstruse or obscure, nevertheless required the nice weighing of evidence which must have been attended with difficulty to a jurist in whose mind the principles involved in such determination were newly implanted. The very opinion of the court itself displays a misconception of the bearings of the case and of the principles to be applied in considering the evidence as it apparently settled or was accepted in the mind of the court. The court, for instance, implies, as to the patentee complainant Bole, that if he "was wanting to fix up evidence for the purpose of perjuring himself and to have other people perjure themselves, he would have gotten up evidence that was more material. Of course, these are material in a way, but they are not in any sense controlling." This leaves us at a loss to figure out what the trial judge considered controlling in the case, as complainant only produced two material witnesses in an attempt to bolster up his story (and we may say that the whole case of the complainants is the story of the one witness, complainant Bole, and that unless it can be found the complainant, Bole, first having the inven-

tion of the patent in suit, disclosed it to Wilson before Wilson, as proven, disclosed it to him, the entire case of the appellees must fall), in addition to a so-called deposition contended to have been taken under the rules and admitted by the trial judge over objection by appellants *particularly because the same was not taken duly and regularly within the strict provisions of the new rules*. If, then, the testimony of these two witnesses and one deponent, backed up by a postal card and an amazing sketch or tracing in evidence as Complainants' Exhibit E, are not "in any sense controlling," it is hard to be seen upon what grounds this case was decided by the lower court. For let it be understood Complainants' Exhibit E and said postal card are the only pieces of original evidence offered by the complainants in this case to substantiate the story of Bole backed up by the testimony of his chum and friend Adams, his former employee Naphas, and the alleged deposition story of Bole's former friend Heber.

The paucity of this showing, compared with the full showing made by defendants and the large number of original exhibits introduced by them, established as genuine and dating back to the beginnings of things in the exploitation of the invention of the patent in suit, establishes the wonder in appellants' mind as to what the trial court found to be in any sense controlling in this case as decided. Again, the trial court defends Bole from our attack of want of diligence in and about the invention of the patent in suit assuming that Bole originated such invention. The court in its opinion says:

“Of course, until it was tried out, it would be nonsensical to apply for a patent. He had no opportunity to apply for a patent, associated as he was, with Wilson and Willard, unless they would try it out. * * * I think Wilson was as negligent as Bole in that regard. He was more interested in it, probably, if he were the inventor, than Bole was. He does not make any explanation of why he waited nearly two years to apply for a patent.”

This entire misconception of the doctrine of diligence as applying to the activities of rival claimants of invention qualifies the whole decision of the trial court as a basically wrong interpretation of the law applicable to the facts present. The court excuses Bole for waiting over four years after the time when he contends he conceived of the invention, during nearly two years of which time he was in the employ of or associated with the interests of Wilson, while Wilson was vigorously asserting his right to the invention and manufacturing and selling under-reamers in large quantities containing the same; and furthermore, the court criticises Wilson for negligence when Wilson was thus vigorously asserting his right to the invention and was extensively introducing and exploiting the same. It was not incumbent upon Wilson to apply for patent until the expiration of the two-year period permitted by Sec. 4886 U. S. Revised Statutes. Bole, on the other hand, who does not contend that he ever reduced the invention to practice, is excused in his delay in filing during all of the period of time when Wilson was in his presence asserting his right to the inven-

tion. It was the duty of Bole to speak out during this latter period of time if he contended any rights he had or might have were being invaded, and we contend that he was estopped from asserting against Wilson any rights in and about the invention. It is absurd to expect an explanation from Wilson of why he waited nearly two years to apply for a patent, because the statutes make an explanation for him.

Further, the court seems to consider the unusual, insulting and animus-tinctured letter in evidence as "Bole letter of January 17, 1911," as a natural explosion on the part of Bole, and the court criticises Wilson for making a settlement with Bole and taking Bole's word that he would do nothing more about the invention of the key the inventorship of which he puts forth a claim to in said letter.

Had Wilson acknowledged Bole's inventorship he, Wilson, could not thereafter have applied for patent. He believed that Bole had only been putting up an eleventh-hour claim of inventorship of the key, which is the one novel feature of the combination constituting the invention, in order to get a better settlement, as a debtor, from Wilson, and when Bole agreed forever to put any such claim aside, Wilson doubtless believed he meant it, inasmuch as Wilson must have realized the futility of Bole's asserting any such claim after he, Wilson, had made and sold under-reamers containing the invention some twenty-two months previously without protest from Bole. It would seem as if the factor of human nature escaped the discernment of the court in this phase of the case, as reflected by the court's

findings. The court in its opinion seems to think that it was an unnatural and unusual thing for Wilson to do, namely, to make a settlement with Bole without including in that settlement the controversy concerning the key; and yet, as hereinafter pointed out in detail, the court ruled [line 4, p. 145, transcript] that it was immaterial for Wilson to endeavor to explain why he did not put the key matter into that agreement of settlement. This would look, on the face of the opinion, like reversible error, as would other rulings of the court on the admissibility of evidence, and particularly on the admissibility of the Heber deposition. We do not find in the whole opinion of the court any assertion that Bole invented the key, the gist of the subject of the patent, and disclosed it to Wilson. If this cannot be found, under all of the decisions and doctrines the findings of the lower court must be reversed and Wilson found to be the original inventor of the subject of the patent in suit. We fail to find in the entire opinion of the court anything to support the conclusion reached; and, on the contrary, we believe the most logical tying together of the detailed findings or observation of the court set forth in such opinion would be to produce a finding the direct antithesis of the ultimate finding and conclusion reached by the trial judge.

The court in its opinion makes no reference to that important phase of the case as to which the law, in great amplitude, was presented to the court, namely, the effect upon a federal court of a finding by that special tribunal, the Patent Office, upon the same fact or set of facts, pertaining to questions of originality

and priority of invention. This doctrine will be extensively treated of further on in this presentation, and it is the doctrine strongly announced by the Supreme Court of the United States in *Morgan v. Daniels* in 153 U. S. 120, which goes so far as to say that unless strong and convincing proof is found to the contrary the courts must adopt the findings and conclusions of the Patent Office with respect to the originality and priority of invention contested as between two or more claimants for letters patent (giving the opinion the more limited scope applicable in this case). How the trial judge, after the Patent Office had, as proven at the trial, found Wilson to be the sole, original, true and first inventor of the subject of the patent in suit, instead of Bole, could reverse that finding in effect, and could do so upon a more meager record, particularly in view of the fact that the trial judge was exploring new legal territory, is difficult for appellants to understand. Without in any respect implying that the independent investigation by the trial judge of the evidence was proper and to be expected, it would nevertheless seem that the advice and assistance, as it were, of the Patent Office, rendering services as to the determination of questions of fact, somewhat as a jury assists the court, would have been welcomed by the trial judge, particularly within the sanctioning doctrine of *Morgan v. Daniels*, *supra*. As we shall show this Honorable Court at argument, the patentee Bole took an appeal from the decision initially rendered in the Patent Office awarding priority and originality of invention of the patent in suit to the de-

pendant Wilson, and such appeal eventuated in an affirmation of the decision of the initial tribunal, the board of examiners in chief who heard and determined such appeal strongly endorsing and reiterating the findings of the examiner of interferences. There will be produced at argument a certified copy of the opinion so rendered by the board in the Patent Office, and of which this Honorable Court will be asked to take judicial notice, the same being the certified record of a federal tribunal.

The opinion of the trial judge is also silent with respect to the question of anticipation. There is no traversing by complainants of the proof of defendants that under-reamers containing and embodying the invention of the patent in suit were manufactured and sold in large numbers by the defendants continuously during a period of time extending approximately twenty-two months prior to the date upon which the patentee complainant Bole applied for the letters patent sued under. Alternatively, that is, without consideration of any of the other defenses urged, this defense, under Sec. 4886 of the Revised Statutes, is sufficient to reach a finding for the appellants. The date of the invention by Bole is the date of application, unless he shall have proven an earlier date, which we contend he has not, and we contend that all the circumstances tend to establish this contention, for, had Bole invented and disclosed the subject of the patent in suit at a time earlier than the initiation of Wilson's vigorous assertion of his claim to the invention and his vigorous exploitation of the same, any

human conduct on his part of a kind to be considered by this court in weighing the issues of this case would have led him to apply for a patent at least as soon as Wilson commenced the assertion of such rights, or at least would have led him to protest such assertion and to speak out and make claim of inventorship in himself. So on these phases of the case, which, to appellant, seem controlling, we find the opinion of the court silent. It is true that the trial court saw and heard the witnesses, with the exception of the witness Heber for complainants, whereas the Patent Office considered their evidence and presentation in deposition form. But even at that the evidence must be considered *per se*, and the preponderance of evidence must be determined, and it is appellant's contention that unless each and every one of appellee's witnesses is to be believed in each and every particular, and unless the appellee Bole is to be believed in each and every particular, and further, unless approximately all of the many witnesses for the appellants are to be disbelieved and discredited in practically each and every particular, the decision of the lower court must be reversed. It is not conceivable that a witness litigant like Bole, whose story, in the main, is uncorroborated by word of mouth or genuine evidence, and whose story in fact is twisted out of any presentable shape by his own confusion and admissions on cross-examination, and whose story must alone, and uncorroborated, be believed as against the denials and assertions of numerous witnesses, and the corroboration of whose story is as scant and meager and dubious as the record in this case shows, can pre-

vail, even if the trial court sees him and hears him. It must be, from the above and other considerations, that the trial judge, delving for the first time into the principles of the patent law from a judicial standpoint, if from none other, reached out in what is, from his opinion, an apparent misconception and confusion of principles of patent law and misapplication of the same to the facts, and picked out of the patchwork of the case some single thread the color of which caught his eye for the moment, and by that thread suspended his findings, the security of which suspension we respectfully challenge.

II.

The Inadmissibility of the Heber Deposition.

We have pointed out that the complainant Bole, who was the applicant for the patent sued under and assigned an interest therein to Edward Doble, the other complainant, is supported in his case by only two witnesses and the deponent Heber. One witness, Adams, testified as of an alleged disclosure to him of the invention, or the key portion thereof, by Bole, in September, 1908. The other witness, Naphas, testified as to the removal of a key by Bole from a Wilson reamer, *after the key had been manufactured and put in the reamer at the shop and in the business of the defendants, in 1911.* We shall show that his testimony is entirely discredited, inasmuch as he fixes the time by certain work in the shop which was not performed in that shop even during that entire year. There is not

a single thread of evidence to support the contention of Bole that he disclosed the invention to Wilson prior to Wilson's activity, even assuming Bole was in possession of the invention at that time. The deponent Heber also testifies to the alleged disclosure by Bole to him of the invention, or of the key portion thereof, in September, 1908. This, supplemented by the postal card in evidence as Complainants' Exhibit D, and which is introduced to show that Bole was in the vicinity of Heber in September, 1908, and Complainants' Exhibit E, tracing or sketch, completes the substance of the evidence and testimony on behalf of the complainants. And this sketch in itself and on its face is for a "key remover for new reamer if adopted." It is not for the key, the only new part of the new reamer, which was made by Wilson and never made by Bole, and shows an inoperative construction, inasmuch as the key and the lever shown therein and faithfully reproduced by defendants and put in the hands of the complainant Bole when on the stand, were with futility attempted to be operated by Bole, he being unable to remove the key from the reamer with the lever. It will be seen how vital it is to the making out of any case by the appellees that this deposition of Heber should be allowed to remain in the case. Without it, Bole has only the attempted corroboration of Adams as to the 1908 alleged disclosure of the key portion of the invention. Beyond that he has nothing but a postal card and, as we shall show, an exceedingly suspicious sketch or tracing and a contradicted and unavailing witness, Naphas. As to the postal card incident, we raise no

contention that Bole was not in Maricopa in September, 1898, but we do contend that Bole never had the invention at that time, and never disclosed it to Heber and Adams at that time.

The record in this case shows that the notice to take the deposition of Heber was given more than a hundred days after the case was at issue on the bill and answer under the equity rules [lines 16-25, p. . .]

Such a deposition could only be taken, not under rule 69, which provided for taking such a deposition out of court within certain times, but rather under new equity rule 47, which is as follows:

“DEPOSITIONS—TO BE TAKEN IN EXCEPTIONAL INSTANCES. The court, upon application of either party, when allowed by statute, or for good and exceptional cause for departing from the general rule, to be shown by affidavit, may permit the deposition of named witnesses, to be used before the court or upon a reference to a master, to be taken before an examiner or other named official, upon the notice and terms specified in the order. All depositions taken under a statute, or under any such order of the court, shall be taken and filed as follows, unless otherwise ordered by the court or judge for good cause shown: Those of the plaintiff within sixty days from the time the cause is at issue; those of the defendant within thirty days from the expiration of the time for the filing of plaintiff’s depositions; and rebutting depositions by either party within twenty days after the time for taking original depositions expires.”

There is no showing in this cause that any application was made to the court for permission to take this Heber deposition, and of course no affidavit showing any good and exceptional cause for departing from the general rule, and such alleged deposition was taken *more than a hundred days* after the time the case was at issue. Equity rule 31 specifies that the cause shall be deemed to be at issue upon the filing of the answer. In this case a counterclaim was interposed, but the order to strike that out was entered over one hundred days before notice of the alleged deposition was given. It is manifest, therefore, that under the new equity rules this alleged deposition was not noticed or taken in proper time, and that the procedure was not in accordance with the rule, even in the attempted taking of the same, no application being made to the court as required by rule 47, which provides such application is to be made even "when allowed by statute." It is only under the provisions of the *de bene esse* statutes, Secs. 862-3 *et seq.*, that such procedure could be taken, and such procedure cannot properly be taken under this rule without application to the court. We invite this Honorable Court's attention to matter included in line 3, p. 709, to line 32, p. 711, as showing the procedure before the trial judge with respect, finally, to the admission of this alleged deposition. Defendants pointed out, as therein shown, that defendants had not attended the taking of a deposition or acquiesced in or countenanced its taking, for, had we so done, we doubtless would have been in a singular position before the trial court. We remained away from the taking of

that deposition purposely, not wishing to countenance it in any respect and not wishing the argument to be made that we were there and ready and could have cross-examined. On the trial we pointed out, as the record shows, that the trial judge had stated that possibly defendants had been remiss within any considerations of equity in not moving earlier to suppress this deposition. It is defendants' contention that we moved at the proper time, namely, when it was offered, and it is our contention that it is not good equity for a man to depart from the plain spirit and import of the equity rules. The point remains that complainants did not produce the witness at the trial, although, as pointed out to the trial court at the time, the witness was in California not long before. We made to the trial court the suggestion that we be permitted to read the deposition of this same witness Heber taken in the interference proceeding between the party Wilson and the party Bole concerning this same key invention matter. It was not adopted. And we pointed out to the trial court that we remained away through caution and not through negligence, but, as the transcript shows, the court stated that it thought the proper practice was to make a motion to suppress the deposition. It is defendants' contention that this motion, in effect, was made in our objection to the consideration of the alleged Heber deposition. Apparently it was not the form of our motion but the time of our objecting that the court hinged its ruling upon, the objection to the deposition being overruled. We believe it was entirely within the proper discretion of the court

to admit the other Heber deposition and show the variance between the same and the alleged deposition offered, inasmuch as it is settled law that the records of the Patent Office may be considered in the courts pertinent to the determination of questions of fact, as within the doctrine of *Morgan v. Daniels, supra*.

Either rule 47 means that a deposition must be taken out of court in a certain manner and within a certain time and upon a certain preliminary procedure before the court, or else, appellants contend, its entire meaning and purpose is vitiated and destroyed. Appellants were entitled to cross-examine the witness Heber, and to do so in open court so that the court could see and hear such witness, of which we were particularly desirous in the case in question and concerning the witness in question. What appellees did was to informally take the recitation of a man, and without warrant by the rules, and what the trial judge did was to sanction such procedure and, in effect, deny us our right of cross-examination of the witness and our right to have him seen and heard by the court.

There is on this question a recent decision rendered in the Southern District of New York, by District Judge Mayer, on the 23rd of February, 1915, and not reported at the time of the trial of this case, namely, *Victor Talking Machine Company v. Sonora Phonograph Corporation*, 221 Fed. R. 676. In that decision it was held that under new equity rule 47, which prescribes the time after the case is at issue within which depositions shall be taken, unless otherwise designated by special order, it is the duty of the court, on motion

of the adverse party, to suppress the deposition taken after such time and without application for such an order. We call particular attention to the text of this decision, from which excerpts are here quoted (p. 677) :

“These rules, with others, were designed to expedite the progress of suits in equity. After the lapse of time under the rules the cause is automatically placed on the calendar, and any departure from the automatic action of the rules in various respects may be had only when ‘otherwise ordered by the court or judge for good cause shown.’ If, therefore, after the time expiration, it becomes necessary to take depositions, there is no difficulty in making a proper presentation to the court or judge and obtaining an appropriate order.”

Why did not the complainants in this case make application to the court for such order?

It will be urged by appellees that rule 47 cannot limit the time of taking depositions so as to abridge any rights inherent under the revised statutes of the United States, in view of Sec. 863. As to that, we contend that the new rules do not abridge any right, but simply point out, as in rule 47, how these rights are to be enjoyed and exercised. In the opinion under discussion the court says as to this (p. 678) :

“It is urged, however, that rule 47 cannot limit the time of taking depositions, in view of Sec. 863 of the United States Revised Statutes, * * * and that, where the witness is one within the purview of that section, a deposition may be taken after the time prescribed in rule 47. But rule 47 refers, among other things, to ‘all depositions taken under a *statute*,’ and,

as it must be assumed that the Supreme Court was construing (among others) Sec. 863, the validity of the rule is, of course, conclusive upon this court. * * * In the suits at bar plaintiff gave notice of the taking of depositions on December 20, 1913, some six months after issue was joined. Neither rule 47 nor rule 1 of this court was complied with. Defendant promptly and clearly notified plaintiff that it objected to this taking of testimony by deposition, that its counsel would not attend, and that it would move at the trial to strike out the testimony thus taken and for further germane relief. Nevertheless plaintiff proceeded, and, in doing so, it took its chances. There was nothing further which defendant was called upon to do. *It might have waited until the trial*, but, instead, has moved now, and, even if laches was an answer (which I doubt) there is none in this case."

It is pointed out that the court held that the defendant might have waited until the trial, and that even if laches was an answer ("which I doubt), there is none in this case." The court further points out that upon the observance of the rule defendant had the right to rely, and a motion to suppress the fact depositions was granted. It is evident that the court was of the opinion that laches would not be an answer, and that the defendant might have waited until the trial, which we did. The very fact that we remained away from the taking of such deposition was enough to put the complainants upon their guard and warning to produce the deponent Heber at the trial. It is our contention that, for the reasons

above set forth, and within the fair interpretation of the opinion just referred to, no deposition of Heber was taken, and that the trial court judge was in error in admitting such deposition. We respectfully and urgently solicit this Honorable Court that the deposition of Heber be not considered in its deliberations, and that the appellees' case on testimony be limited to the witnesses Bole, Adams and Naphas.

III.

The Relations Between the Parties.

The record in this case shows [line 1, p. 131, to line 3, p. 136, inclusive, of the transcript] that the defendant Wilson has been acquainted with the complainant Bole since the year 1904 or 1905; that Bole was an employee of the Bakersfield Iron Works at the time Wilson was manager of that institution, for possibly a year, as a helper or machinist, and that he became an employee at the Wilson & Willard Manufacturing Company's plant, that is, the defendant corporation's plant, at Los Angeles, California, in 1907; that he was there as a machinist and worked on a lathe and did shop work for a year or so; that afterwards Mr. Willard, Mr. Wilson's partner in the defendant corporation, joined with Bole in the pump business, the pump being made by the defendant corporation and Bole working in the shop part of the time and part of the time in the field soliciting business; that pumps were the only things the defendant corporation manufactured for Bole and Willard; and that the pump

department never made any reamers and were merely customers of the Wilson & Willard Manufacturing Company, with only one or two exceptions, owning only one or two machines, small lathes, which were used in the manufacture of pumps, the Bole Pump Company, as this pump business was called, being not in position to manufacture under-reamers or any other tools; that the relations became strained between the Bole Pump Company and the defendant corporation, and that finally a settlement was entered into between them about the first of February, 1913, *some twelve days before Bole filed his application for the patent in suit*, such settlement following the receipt by Wilson of the insulting and preposterous letter heretofore referred to, being Defendants' Exhibit Bole letter of January 17, 1911. The transcript further shows [line 19, p. 142, to line 11, p. 147] that this settlement was entered into after Wilson had attempted to point out to Bole that he was endeavoring to help him, as his interests had for a long time, and that Bole replied he was hasty in writing the letter of January 17, 1911; and that Wilson asked him, in regard to any claim to the invention of the reamer key Bole had in mind, why he had not told him before that he thought he, Bole, was the inventor of it; and that that was the first intimation he ever dreamed of that Bole claimed any part whatever in the invention of the key. Wilson testifies that Bole said, "Well, be that as it may, I will do nothing further with this anyway. If we can get our accounts here settled satisfactorily I will do nothing further with the key." Wilson further testi-

fies that after the preliminary terms of this agreement were discussed between Willard, Bole and W. W. Wilson, his brother, an agreement was dictated, which is in evidence. The witness Wilson then testifies as follows: "Mr. Bole said if he could get a satisfactory settlement of his account he would do nothing further with the key matter. I was endeavoring to explain why I did not wish to put it in that agreement." The record then shows that the court said: "That is not material."

We pause at this time to compare this testimony of the witness with that portion of the opinion of the trial judge which is as follows: "I think it was a very unnatural and unusual thing for Mr. Wilson to do, if he claimed to be the inventor of that thing, to make a settlement with Bole without including in that settlement the controversy concerning the key. It was very unbusinesslike and very unnatural."

If the court considered this act of Wilson's very unbusinesslike and very unnatural, why did the court hold that it was not material for the witness to explain why he did not wish to put the key matter in the agreement? In many places the court ruled similarly where an attempt was made to present evidence showing the relations between the parties, including the relations between the party Double, assignee of an interest in the Bole patent in suit and one of the complainants, and the president of the Union Tool Company, a concern in direct competition with the defendants in the manufacture of oil well tools, including underreamers, which would tend to show a motive for the

assertion of the claim of invention by Bole with respect to the subject of the letters patent sued on herein, namely, to persecute and harass the defendants, and further developing the animus shown by Bole in his letter of January 17, 1911.

Adverting again to the testimony last referred to, and now on p. 145 *et seq.* of the transcript, we find testimony of Wilson that Bole stated, "I see you have made no mention of the key matter in this agreement," and that Wilson replied, "Bob, I don't believe it has any place in this contract. This is a contract between the Bole Pump Company and the Wilson & Willard Manufacturing Company; and whatever agreement, if you think you have any rights at all to this key, that will be made between you and I, will be a personal matter. But, it may be a part of this contract, in consideration of the contract, as you suggested that if you can get a satisfactory settlement of this pump account you would agree to waive any claim that you may have to this key," and that Wilson further said, "It may to that extent belong in this contract; but I hardly think it does."

The witness admits he probably should have gone to a lawyer. But he states that Bole replied, "Well, I will do nothing further with the key matter. I will give you no further trouble with that." This was less than three weeks after Wilson had received his first knowledge of Bole's assertion of any right whatsoever with respect to the origination of the single-piece key under discussion, namely, by the letter of January 17, 1911.

We again insist that this promise of Bole's was a consideration for the settlement he got, and was a waiver of his right to make any claim with respect to the invention, particularly as against the defendants in this case. If reduced to formal agreement, the matter might have been serious for Wilson as being a recognition of some right to the invention or some claim of right to the invention in Bole. Thus we have in this complainant a disgruntled person who made a cheap settlement with the defendants, Willard of the defendant corporation having severed his interest with the Bole Pump Company [Qs 493-494, pp. 386-387, transcript, testimony of Willard given in *interference Wilson v. Bole*]. Bole was a mechanic under Wilson both at the Bakersfield shop and at the defendant corporation's shop, and when he, having gone into business independently and been backed up by Wilson's partner, was called to account, and having been let off with a cheap settlement, he flew at once to Wilson's chief competitor, Double, president of the Union Tool Company, and assigned forthwith and outright to him an interest in the patent in suit. In spite of the court's ruling that the relations between Wilson and Double were immaterial, or the like, the deposition of Willard given in the interference referred to concerning the subject of the patent in suit was admitted on motion of the complainants, and the testimony in that case [Qs 214-236, pp. 338-341, transcript] shows fully the bitter competition between the interests of Double and the interests of Wilson, including litigation between said interests over Wilson under-reamers.

Bole doubtless found a willing ear in Double for his scheme to apply for a patent on the Wilson reamer key and attempt to hold the same over the defendants in this case as he has been permitted to do by the trial court. We contend that it is clearly shown in the record of this case that Bole, even if he ever dreamed of this key for any purpose in the year 1908, never disclosed it to Wilson, and was not diligent in applying for a patent for same, and that Wilson independently invented the key, and was diligent, and instituted the practice of the invention which, by a matter of some twenty-two months, anticipated the Bole patent in suit. As a matter of fact we shall show that Wilson is proven to have disclosed the invention to Bole in 1911, immediately prior to Wilson's diligent reduction of the invention to practice.

IV.

Bole's Case.

Bole contends that he made the invention during September, 1908, while on a trip to Maricopa, California, during which he visited the shop of the Sunset Monarch Oil Company, where he took an order for a Wilson under-reamer and a Bole spear from Heber, who was foreman of the shop, and that then and there he disclosed the invention with sketches to Heber and to Adams, both friends of his, and sent in this order to the Wilson & Willard Manufacturing Company with a sketch of the description of the key. *The order, it is conceded, was never filled with any such key.* Bole further contends he disclosed the invention to Wilson

prior to the latter part of January, 1911, which is fixed at the time that Wilson came into possession of the invention independently of Bole, as we contend. It is also claimed by Bole that he was the first to pry out such a key from the Wilson under-reamer, this being put forth to support his contention that he invented the key. As to this the discredited witness Naphas testifies. This, in a nutshell, is Bole's whole case, with the exception of the matter of the alleged January 27, 1911, sketch, being the exhibit heretofore referred to, and which Bole claims he made on that date, signed, and obtained the signatures of the witnesses Fahnstock and Grigsby, then in the employ of the Wilson & Willard Manufacturing Company, the defendant, both of which witnesses—Grigsby being not now in the employ of that company—deny, to the best of their recollection, ever having seen the sketch before it was produced on the taking of proofs in the interference referred to. It is not contended that this sketch ever was shown to Wilson before the interference proceedings in 1914, and we will attempt, piecemeal, to dissect the same and to show what an enormity it is as a piece of evidence. Bole does not call a single witness to corroborate him in his alleged disclosure of the invention to Wilson, and Wilson denies it. It is conceded that Bole stood around for upwards of twenty-two months while Wilson diligently practiced the invention, prior to the application by Bole, and never raised a hand in protest or said a word in objection or in claim of proprietorship or origination until the letter of January 17, 1913, a few weeks before the settlement between Bole and

the defendant corporation. Irrespective of how the witnesses look or how they talk before the court—and it is to be borne in mind that the defendant Wilson, his former partner Willard, and his brother, W. W. Wilson, are substantial individuals in the community and in manufacturing circles—how can such an uncorroborated and unsubstantial story, and such a contradicted story, be given credence by the court? Bole is contradicted by Fahnestock and Grigsby; Naphas is discredited on the face of his own record; Adams is shown to be a strong friend and partisan of Bole and not to have received a full disclosure of the invention, even if he and Bole are believed; and Heber comes before us as a deponent unrecognized by the equity rules and offers his testimony in the shadow of the court house instead of in the court room and without giving the court an opportunity to see and hear him or the defendants to cross-examine him. And Bole is directly contradicted by Wilson as to his alleged disclosure to Wilson, and Willard entirely fails to corroborate him as to any disclosure of the key of the invention by the order sent in for the Wilson reamer from Maricopa in 1908.

As we have pointed out, Bole's proof, to make out his case, rests upon the testimony of only himself, his chum Adams, with whom he goes hunting, plays pool, etc., when they can get together; Heber, likewise an old friend; and Naphas, former manager of his pump business with the Wilson & Willard Manufacturing Company, and who ought to know if Bole ever made

any such invention as the key for reamers, as he claims to have made, but who does not testify anything about this, and who was not called as a witness in the interference, although Bole testifies in the interference that Naphas was present, he thought, at one of the times when he discussed this key with Mr. Wilson prior to Mr. Wilson's date of invention [Qs 76-81, pp. 599-600, transcript]. Bole claims that he explained to his brother-in-law, Hubbard, that he intended to do certain things for holding the lower end of the spring in the Wilson under-reamer, in 1908, but does not call him as a witness to the disclosure of his invention [lines 8-19, p. 577, record]. He also testifies that he showed the Bole sketch of January 27, 1911, to Austin, the shoe man, in February, 1911, he being a man in Los Angeles, and yet he does not call him as a witness [lines 22-26, p. 578, transcript], nor his father similarly.

We can readily dispose of Naphas, who is supposed to have seen Bole remove the key from presumably the first reamer built by Wilson including the key (and Bole built no reamer including the key in all the years he claims he had the invention), for Naphas fixed the time as being about the middle of February, or maybe a little later, in 1911 [lines 8-13, p. 615, transcript], and fixes the time as in February, 1911, because, he says, they were making four and a half inch pumps in March, 1911 [lines 3-27, p. 617, transcript]. W. W. Wilson testifies [lines 6-27, p. 679, transcript] that he was in charge of the office of the Wilson & Willard

Manufacturing Company, the defendant, in 1911, and that no four and a half inch pumps were made in the year 1911 for Mr. Bole or for the Bole Pump Company at the Wilson & Willard Manufacturing Company's shop. Naphas is entirely discredited by this testimony, and it is not attempted to show by any other witness that such pumps were being made there in that year. The testimony does not amount to anything in a way, for Bole may have pried out a key of the Wilson reamer after Houriet did, and the record shows clearly that Houriet was the first man to pry out this key, as we shall see.

Right at this point it may be well to pause and refer to the patent and point out what is the invention in this case. It consists purely and solely and essentially in the key feature, namely, the single-piece device which is inserted in the body of the reamer and through slots in the sides thereof and through a slot in the spring-actuated rod and held in place by the spring, having downly-directed shoulders forming a wing or projection to fit down into the body of the reamer and preventing the key from lateral displacement unless one end of it is lifted up so that the key can be driven out at the other end. When the key is in beneath the spring, the spring is held in place, and through it the spring-actuated rod, which carries the cutters or bits which play up and down and expand and collapse, in bringing the cutters into working position and in bringing them into contracted position for withdrawing the reamer from the hole, respectively. It will not be denied by appellees that Wilson had long previously,

at least as early as the year 1907, devised a two-piece key shown in evidence as Wilson Exhibit Photo A of Wilson Reamer Two-piece Key Device, and also reflected in Wilson Exhibit Photo B of Two-piece Key Device; that this was long used by Wilson, and that they were made at the shop in Bakersfield at the time Bole was working there; and that the genesis of the single-piece key invention is clearly associated with Wilson's efforts and not Bole's. And further, all of the other parts and features of the Wilson reamer shown in the patent of Bole in suit had been previously devised by Wilson and extensively manufactured and sold by him, and patented by him, Complainant's Exhibit B being a copy of the letters patent issued to Wilson in 1906, showing still other means for confining the lower end of the spring, namely, a block and screws or plugs for holding the block in the body of the reamer and provided with a hole through which the spring-actuated rod played.

Bole, therefore, attempts to show, by himself and Heber and Adams, and by the sketch of January 27, 1911, that he, Bole, invented this single-piece key, which was admittedly never manufactured or used by him, and which Wilson admittedly put into service and sold in his reamers, commencing work on the first of the same as early as February, 1911. It is Bole's contention that he made this invention while at Maricopa in September, 1908, and then and there disclosed it to Heber and Adams.

It is our contention that there is no proper testimony of Heber in this case, and he was not cross-examined,

and, of course, had the benefit of his experience in testifying in the interference and such coaching as he received afterwards. As to Adams, this alleged disclosure of Bole to him, and likewise as to the disclosure of Bole to Heber, was only fragmentary, and in Adams' case was by a sketch of the key drawn on the lathe with a piece of chalk [lines 9-12, p. 625, transcript]. He admits he has long known Bole, about twelve years; that he calls him "Bob," as Bole calls him "Gus," and that he would do a whole lot to help "Bob" out, they being close friends [lines 15-22, p. 626, transcript]. He admits that he also worked in the Bakersfield Iron Works, where the Wilson reamers were being made, and that they had this two-piece key, one of which held the other in place, and which was, in turn, held in place by a plug, and that he saw them there prior to September, 1908 [lines 23-9, pp. 626-627; lines 10-20, p. 627, transcript]. He likewise testifies that since September, 1908, he repaired reamers with this two-piece key, and worked on them, and since 1912 has seen a good many of the Wilson under-reamers, being the only under-reamers ever made with this single-piece key prior to the taking of testimony in this case, with such single-piece key contained therein [lines 22-3, pp. 627-628, transcript]. There is little doubt but what Bole in September, 1908, was discussing this two-piece key with both Heber and Adams, or at least that is our contention, inasmuch as he admits that when coming down to Los Angeles to testify in the interference that he saw the one-piece key in a sketch or drawing which Bole was discussing with his attorney, Mr. Lyon [lines

9-15, p. 629; lines 16-21, p. 629, transcript], and it is our contention that this one-piece key structure was put into Adams' mind at that time and there was thus cultivated the impression in his mind that it was this key Bole showed to him in 1908 instead of the two-piece key. It is significant that, although Adams testifies that they had had trouble with the two-piece key, no attempt was made to make any such single-piece key back in 1908 at the shop in Maricopa, for manifestly it would have been simple enough to make, and the record shows they had two-piece key Wilson reamers to repair in that shop after September, 1908, although they made two-piece keys at that shop [line 24, p. 631, to line 26, p. 633, transcript]. He admits this sketch of the key made by Bole, that he says Bole made on his lathe, was only there about ten minutes, and that he rubbed it out; that that evening he was with his friend "Bob" Bole and did not see him send in any order for a reamer, nor did they talk about a reamer that evening, and that he did not see him make out an order at all on that day or on that trip [lines 15-16, pp. 634-635, transcript]. He admits it was a greasy surface upon which the chalk sketch was made, but *that the surface* HAPPENED to be clean before "Bob" Bole made the sketch, and admits that he does not remember a thing written on that lathe in chalk that same year except this key sketch he is talking about [lines 19-12, pp. 637-638, transcript]. With the Heber deposition out of consideration, Bole has nothing to prove his possession of this invention before Wilson with the exception of this fugitive alleged chalk sketch

supposed to have been made nearly two and a half years before, and which produced no results either in the form of application for patent by Bole or manufacture of any such reamer with such key or repair of any reamer to include such key, and Bole himself was connected with the reamer-making shop of the Wilson & Willard Manufacturing Company and never saw to it that such a key was made, although Wilson would have grasped it with avidity, without doubt, had any such suggestion ever come before him, for he industriously went to work to utilize the key within a few days after he devised it, as we will point out in considering the testimony concerning his independent invention of this key.

We regret that the court did not permit us to put in evidence the deposition of Heber taken in the interference, which would have shown many reasons why it would have been desirable to have this witness before the court.

Bole testifies that he sent in an order to the Wilson & Willard Manufacturing Company for a reamer with such single-piece key, and an order for a Bole spear. It is admitted that the order for a reamer came in, and the order for a spear, in September, 1908, from Bole, and the records of the defendant corporation show such orders duly entered up, but no reference is made in any of those entries to such a single-piece key. Bole says he sent in his letter to Willard, but that letter could not be found, and if it was ever in the files of the Wilson & Willard Manufacturing Company the presumption is that Bole knows where it went. He

had full access for years to the records of that shop. In the interference proceeding Bole testified that this letter sent to Willard showing the key for the reamer with a sketch and description was sent to the Wilson & Willard Manufacturing Company [Qs 35-36, p. 591, transcript], and therefore not sent to Willard. In the present case he testified that he sent this order letter to Mr. Willard, who was getting his mail at his house on West Thirty-seventh place in Los Angeles [line 10, p. 492, to line 13, p. 493, transcript]. He says that when he returned from Maricopa he asked Mr. Willard about this order and Mr. Willard said Mr. Wilson (who was then in Bakersfield) refused to have the order filled. Mr. Willard testifies that the order was sent in to the shop of the Wilson & Willard Manufacturing Company; that there was not any sketch in that order that he can remember of, and that he cannot definitely recollect of any sketch or any showing other than the written part of the order, and that he cannot tell us anything of that sort that he remembers about that order any more than that he received the order for the different articles specified; that there was no delay incidental to the taking up of that work that he remembers, namely, the work on that order, and that he does not know that he communicated with Wilson, the defendant, about that particular reamer in any way, and that he has no such recollection, and that he does not remember having sent Mr. Wilson that order or any letter regarding it or any communication of any kind unless possibly he told Wilson over the telephone that he had had an order or that Bole had sent down

an order; that he does not remember telling Bole after he returned from Maricopa that he communicated with Wilson about that order and that Wilson had refused to make any change in the order, having no recollection as to that; and that a standard reamer was shipped on that order, not different from any other reamer made in the factory; and that he does not remember any complaint received from the Sunset Monarch Oil Company with respect to the nature of that reamer [line 1, p. 651, line 1, p. 516, transcript]. Willard testifies in the interference proceeding [Q. 303, pp. 354-355, transcript] that when he looked up the shop records two or three years previously to attempt to locate what was sent in with this order of Bole's from Maricopa, and when he could not find any written requisition or order from Bole, that the original order was missing. This was long before this controversy arose. Where did that order go to? It was long before Bole ever claimed to Wilson—which we contend was by the letter of January 17, 1913—that Bole was the inventor. Again, where did this order go to? Bole and Willard are shown to have been old, close friends, and yet Willard testifies squarely against his friend, his testimony strengthening in the interference case as he proceeds, he having a perfect right to change his testimony or increase its force and strength before the ending of his deposition. He testifies that he never saw any sketches distributed throughout the letter order of September, 1908 [RDQ 112, pp. 435-436, transcript], clearly contradicting Bole as to the sketches being sent in with this order, after having time to

think over the matter, and Bole and Willard, it is to be remembered, were frequently out on trips and at ball games together, on which occasions Bole discussed with him contemplated business plans or changes in devices that he had under way [Qs 63-65, p. 427, transcript].

Willard further testifies that there were no sketches in that letter or order, that he saw, under recross-examination [RXQs 165-167, p. 445, transcript].

So Bole is squarely contradicted as to this order letter alleged to contain sketches and description of the key constituting the essence of the invention of the patent in suit. There remains, then, as to any claim of Bole as to the invention, prior to the time when Wilson put the invention into practice, only the meager testimony of Adams and the fugitive chalk sketch on the lathe, and the improper deposition of Heber, these both produced from two old friends of Bole's, and this meager stuff is wiped out, in effect, by the contradiction of Bole's friend Willard. Wilson denies that Bole ever disclosed this invention to him, pointing out, as we have shown, that the first he ever heard of Bole's claim of such invention was by the letter of January 27, 1913, over four years after Bole claims to have made the invention. Wilson's denial that Bole ever put before him in any way prior to his making out the order for making over reamer 120 with the first single-piece key put into a reamer, as a design, construction or the like, or in any manner exhibiting or saying anything to Wilson about same, the key that he alleged he invented prior to that time, in lines 20-31, p. 96,

transcript, leaves Bole at sea, with no terra firma to stand upon as to his putting this invention before Wilson before Wilson independently worked it out and put it into practice, even upon the shadowy assumption that he had the invention or was in possession of it theretofore. This first reamer with the key was made over on an order, number 6904, placed February 3, 1911, as see Defendants' Exhibit Order Papers and Sketches Pertinent to the Making Over of Reamer 120, and order number 6904, together with the shipping envelope (respectively Defendants' Exhibits 6 and 7), and Defendants' Exhibit 8.

Bole's attempt to carry work on the invention in the shop of the defendant corporation prior to the work commenced on reamer 120 under Wilson's order of February 3, 1911, is reflected in line 7, p. 573, to line 17, p. 575]. In this he sadly fails and admits his error, for while he states he is positive about the first reamer because it is his opinion that the work started on that reamer before the 3rd of February, and he would say about the middle of January, when he is asked if it was made before his alleged sketch of January 27, 1911, he admits that he should judge he was wrong, and that he has no foundation for his statement that February 3rd was too late a date for the commencement of the first reamer with a single-piece key. *Of course, Bole would not be foolish enough to admit that anything was done about this key in the shop before the time he says he made a sketch of it; for it would be foolish to attempt to perpetuate a thing by means of any such sketch as that of January 27,*

1911, if in fact it had been made on a shop order and that order perpetuated the transaction—unless it were to perpetuate the key remover, which is, on the very face of that sketch, the thing the sketch is supposed to show. It is very significant that this sketch was gotten up a day after Wilson says he first commenced to definitely work out this key, and that Bole says it was made in Wilson's shop. Without doubt he obtained any idea that he ever had of this key from Wilson. Bole certainly stands peculiarly alone in attempting to make out his case of priority of invention or of any disclosure to Wilson.

BOLE'S EXHIBIT JANUARY 27, 1911, SKETCH.

Bole's only other physical evidence, aside from the postal card above referred to, which does not prove anything in point, or only helps to prove what we admit, that Bole was in Maricopa in September, 1908, is this remarkable exhibit, Complainants' Exhibit E, or the so-called Bole sketch of January 27, 1911. As to this sketch, which he says he made at the shop of the Wilson & Willard Manufacturing Company on January 27, 1911, a most significant thing is that upon its very face Bole is referred to as the inventor of a key-removing tool and not of the one-piece key itself. It is most reasonable to assume that Bole made this sketch after the invention in issue in this case was disclosed to him by Wilson, and to perpetuate Bole's idea of a lever for prying out the one-piece key. The first presentation of this sketch to vision stamps it as either an abortion or a monstrosity.

It is doubtful if ever there was previously offered in evidence a purported witnessed sketch of which the signatures of the purported witnesses occupied the central portion of the field, with the matter purporting to be witnessed tucked into one corner, and with the purported inventor's name beneath the purported signatures of the witnesses. The one thing that stands out in this sketch is the matter comprising the word "witness" and the writing "W. H. Fahnestock" and "E. F. Grigsby." It is significant the sketch was made in indelible purple pencil and the witnesses' signatures were made in black ink. This sketch is on an extremely small piece of linen, and the presumption is that, as neither Fahnestock nor Grigsby remembers ever having seen it before the interference proceeding, that the signatures of these purported witnesses were on the linen surface first, there being portions of the purplish indelible pencil matter superimposed upon the black signature lines so as to tend to prove this sequence; that the alleged witnesses' signatures must have been written upon the surface when it was part of a larger surface, as it would be impossible to hold the material of the exhibit in its present form and at the same time get between the fingers or anything else so holding it, and make the bold signatures appearing under the word "witness"; and no person could write the uncramped, bold, purported signatures of the alleged witnesses as they were written on a surface of this form and size, and that whoever wrote the word "Fahnestock" would, of necessity, and because of the well known personal

characteristic, common to all persons, have cramped the writing, at least toward the termination thereof, to prevent running over the right-hand edge of the surface. Probably Bole found these signatures on some drawing on linen, in the lower right-hand corner of it, where there is a finished selvage edge on the bottom of the linen, put in the matter above and below the signatures, together with the word "witness," and thus constructed this exhibit. Although in his testimony in the interference he does not say anything about trimming down this sketch from a larger surface, in the present case he testifies that there was a larger sheet of material when Fahnestock and Grigsby signed their names to it [line 17, p. 541, to line 17, p. 542, transcript]. This discrepancy in his testimony is extremely interesting, also his testimony that the tracing was made from a drawing [lines 1-6, p. 543, transcript], and that he supposed he destroyed that drawing. There is not a word said about this in his original deposition, which is in evidence. Grigsby testifies that the first time he ever saw this sketch, Complainants' Exhibit E, to his recollection, was in Mr. Lyon's office, the attorney for the complainants, at the time Mr. Lyon was taking testimony for Bole in the interference case, which was in 1914 [lines 4-17, p. 661, transcript]. Fahnestock testifies that the first time he ever saw the sketch was when he was called upon to testify in the interference proceedings in 1914, to the best of his knowledge [lines 10-15, pp. 665-666, transcript]. Grigsby does not remember ever signing on tracing paper for anyone [lines 24-32,

p. 661, transcript]. This piece of evidence, namely, this sketch, Complainants' Exhibit E, therefore goes begging, with no support but Bole's own testimony.

In order to show that whatever Bole did get up, if he got up anything pertinent to this lever for removing the key, although the record shows such levers were in use in this shop for other purposes prior to January 27, 1911, was of no account anyway, a key and lever drawn accurately to the scale of these parts shown in this sketch having been produced and put by defendants before Bole on his cross-examination and Bole admitted that they were practically the same as the sketch, and he was then asked to say if that key is the same size as the key in the Wilson reamer in evidence, Defendants' Exhibit 1, or Defendants' Exhibit Single-piece Key Reamer, and he replies that he finds that it is. He then is asked to attempt to remove the key and says there is no opportunity to get the lever in under. He then admits that he does not know that he ever intended to use it, but got it up with the idea of protecting it, but never did anything further towards protecting it, never having applied for any patent upon it [line 6, p. 536, to line 1, p. 539]. In other words, whatever Bole did get up, if anything, pertinent to this key, is this lever which he copied from a lever already in the defendants' shop, and this would not work to remove the key. The very thing this sketch of January 27, 1911, purports to show or disclose on the claim of Bole's inventorship is a lever which is useless for the key which Wilson devised. When this sketch was made there is no reasonable proof. It

very well might have been made after Bole had his rupture with Wilson and the attempt was made to pirate upon the business of Wilson, Bole being backed up in this by Wilson's bitterest competitor, Double, of the Union Tool Company.

BOLE APPLIED FOR PATENTS FOR OTHER THINGS.

Apparently Bole considered this key invention, if he ever devised it, to be of so little importance that he did not apply for patent on same until Wilson had thoroughly incorporated the key in his reamer business, so that he could parasitically advance upon Wilson's established business. That it was Bole's practice to file applications for patents for other things is clear from the record. [See lines 1-9, p. 556, transcript.] See also line 20, p. 533, to line 19, p. 534, transcript, which shows that in one case in 1906 or 1907 Bole was particularly diligent about applying for patent the very day he evolved the idea.

BOLE ADMITS JANUARY 27, 1911, SKETCH WAS TO PERPETUATE KEY REMOVER AND NOT KEY.

This highly significant admission is made in line 10, p. 532, to line 19, p. 533. This testimony ties the witness down as to anything in his claim of invention as reflected by this sketch to the lever and not to the key, for he says that he thought, on January 27, 1911, he had invented a new key remover, and that he did not think this better than the key remover he claims he originated in 1908, namely, the system or method of driving a drift under and then driving out the key;

that as a matter of fact he thought the drift was best, that being what was finally adopted by the Wilson people. Apparently he did not think much of this alleged key-remover, which we have shown could not remove the key anyway, by Bole's admitted demonstration in the court room, and as it was already in the shop of the Wilson people in substantial equivalence, he must have known that he had not really invented anything. Such a lever is in evidence as Defendant's Exhibit 9, namely, the lever previously used in the Wilson shop.

That complainant's attorney must have considered this Bole January 27, 1911, sketch peculiar and suspicious is seen from the testimony of the witness Adams [line 9, p. 629, to line 23, p. 629, transcript]; for it seems that when Adams came down to testify in the interference he saw this sketch, and Bole was discussing it with his attorney, Mr. Lyon, and comment was made upon the contrast between the signatures and the drawing.

Another significant thing about this sketch is that Bole testifies he explained the key-remover and key to Fahnestock and Grigsby at the time they are alleged to have witnessed the sketch, and yet, with all the importance that attached to the coming in of the new single-piece key reamer in the Wilson shop, these witnesses cannot remember having ever seen the sketch before testifying in the interference suit years afterward. It is significant also that Bole explained, as he says, to Fahnestock and Grigsby, that it was a *key-remover* shown in the sketch. He doubtless had never

known of the key until Wilson produced it and displayed it to him, and all he was considering in and by this sketch, if it was ever produced anywhere near the time he says it was, was the key-remover, which was a useless thing anyway, and which anyone would be apt to forget, or at least anyone in the shop where the similar lever to that in evidence was known, although Fahnestock and Grigsby would not have been likely to have forgotten any such sketch if it pertained to the important single-piece key. It is significant, further, that Bole cannot remember anything that Fahnestock and Grigsby had to say at the alleged time of disclosure of the sketch [line 13, p. 540, to line 3, p. 541; line 26, p. 577, to line 13, p. 578, transcript]. We contend there never was any such disclosure.

BOLE'S SUM TOTAL OF PROOFS.

Fairly and reasonably marshalling together the offered proofs on behalf of complainant, we find the following evidence:

Bole's Deposition:

Squarely contradicted and discredited by Wilson, Willard, Fahnestock and Grigsby, and only partly supported by Adams and the improper deposition of Heber, Naphas' deposition being rendered worthless by contradiction.

Bole's January 27, 1911, Sketch:

In effect disproven by Fahnestock and Grigsby, the alleged witnesses thereto.

Bole Postal Card Mailed to Heber:

Unchallenged so far as it tends to establish the fact that Bole was in Maricopa during September, 1908, which we admit.

This whole case must fall or stand with Bole's deposition, about which all the rest of the purported evidence clusters; and Bole being discredited and contradicted, and the January 27, 1911, sketch being discredited, this court is asked to find for appellees upon the evidence of an unimpeached postal card.

Again we assert that this court must believe *all* of appellee's witnesses, and that Bole's father, and Austin, the shoe man, and Hubbard, who were not called, would have corroboratively testified; and must disbelieve practically *all* of appellants' witnesses, in order to affirm the decree of the lower court.

Again we reiterate that the lower court erred in finding Bole an original inventor, in finding that Bole ever disclosed the invention to Wilson, in finding Bole a prior inventor if, in fact, he was an original inventor, because of the diligence of Wilson and the total want of diligence of Bole, and in finding that the Bole patent was not, in fact, anticipated and void because of the admitted diligent reduction to practice by Wilson and its long continuance in the presence of Bole during a period of some 22 months before Bole applied for patent, and in not finding that Bole obtained all his knowledge and information about the invention from Wilson.

It was a most remarkable thing for Bole to rely upon

Wilson and his company to preserve his record, if he ever made one, pertinent to the original invention of this key, and at the same time permitted Wilson to manufacture the reamer month after month and vigorously assert his claim thereto without protest and without filing any application for patent. The Patent Office has twice passed upon this same issue of originality and novelty of the key invention as between Bole and Wilson, both times finding Wilson to be the true, original and prior inventor, this interference record being before this court in Defendant's Exhibits, Certificate of Patent Office as to Wilson v. Bole Interference, Certified Copy of File Wrapper in the Matter of the Application of E. C. Wilson in Improvement in Under-Reamers, and the decision of the Examiner of Interferences in the Patent Office finding Wilson the original and prior inventor of the issue of the patent in suit. At the hearing there will be produced for filing certified copy of the decision of the Board of Examiners in Chief affirming the opinion of the Examiner of Interferences, and the court will be asked to receive and consider or take judicial notice of the same, it being a certified record of a decision of a department of the federal government.

V.

**Wilson's Independent Diligent Anticipatory Activity
and his Disclosure of the Invention to Bole.**

We turn now to the record in this case showing the independent and diligent anticipatory activity of Wilson in and about the invention and his disclosure of the

invention to Bole, all dating back in initiation to the last part of January or first part of February, 1911. It is to be borne in mind that Bole is supposed long before to have disclosed the invention to Wilson. Had he so done is it likely Wilson would have slept upon the advantages of this invention, which, in its attractiveness in the trade and field, was so superior an advantage to the old block-and-screw or pin type of spring-confining means and the old two-piece key-and-plug type of spring-confining means,—had as a matter of fact this invention been before him at a prior time?

We will now dissect the testimony of the witnesses for Wilson, bearing in mind that Wilson was the man logically and naturally to produce this invention, inasmuch as he had produced the earlier just-mentioned types of spring-controlling means, and that he, and not Bole, was the reamer-maker, and had been for years, and that it is not shown that Bole ever made a reamer or ever reduced to practice in any manner the invention of the patent in issue.

E. C. Wilson testifies generally as to the nature of his business and that of his company and of his commencement of making reamers back in the year 1904, this testimony showing that he has been closely identified for years with the oil well tool and under-reamer business, and that he has had a training at Stanford University following a public school education [line 28, p. 78, to line 19, p. 94, transcript]. Beginning with line 13, p. 88, and thence continuing on, he testified as follows: That the first order for a reamer with a single-

piece key like that in Defendant's Exhibit Wilson Single-piece Key Reamer, was made up on February 3, 1911; that it was dictated by himself in the office of the Wilson & Willard Manufacturing Company, the defendant, and, when typewritten in the usual form, was sent to the foreman for execution; that William G. Knapp was the foreman of the shop at that time but is not now connected with the shop. The order is produced and is in evidence, together with the companion order, the first being order No. 6904 and the second being order No. 7056 (see Wilson Exhibit February, 1911, Wilson & Willard Manufacturing Company's Shop Record Slips; and Defendant's Exhibits 6, 7 and 8). The latter order, 7056, was made up by Mr. Knapp, and the testimony of Houriet and Ridgren, workmen in the shop, and of Knapp, the foreman, and Willard of the defendant company, all establish the making up of these orders and the execution of the same in the shop. Wilson gave orders, and made a sketch of a Tee for the reamer, and turned it over to Mr. Knapp, at the same time giving him instructions in regard to the type of spring to use and also in regard to the one-piece key which was to be used in that reamer; and that the reamer was changed over, reamer 120, which was a reamer of the old style two-piece key type, into a single-piece key reamer as per his instructions, a larger Tee being made, a larger spring, and a one-piece key like that of the issue, and the lower end of the under-reamer body being drilled out to fit in a safety bolt. He testifies that there was considerable trouble in removing the key, and it was

one day discovered by the machinist Houriet that by simply driving a wedge or the pointed end of a file underneath this key he could pry it up to such a position that the operator could drive it out from the opposite side. It seems that Wilson had always been somewhat troubled about removing the key, and Houriet's solution settled the matter. It will later be seen that Bole, when Wilson disclosed the key to him, suggesting prying it up and driving it out, presumably in line with his ideas about the lever, but that this was not the method adopted [line 21, p. 94, to line 31, p. 97, transcript]. Upon this misadvice Bole rests probably all his foolish contention that he had something to do with designing the key, while he only suggested an unadopted and improper method of prying it out. It seems that this reamer was not sold until along in the early summer, and was shipped to the Norbeck & Nicholson Company in Dakota [line 17, p. 98, to line 12, p. 100, transcript]. It seems that a drawing was made showing the key, by tracing the outline of the key of reamer 120, in evidence with the other record papers pertinent to reamer 120, and whereby were preserved the dimensions of this key, such sketch showing the key to have been completed by April 22, 1911, the witness testifying he made the outline of the key on that date [Knapp testimony, lines 11-6, pp. 213-214, transcript]. The witness E. C. Wilson testifies that he was president of the defendant company when this work was done on reamer 120 to include the single-piece key, and then goes on to testify that the first he had to do with the single-piece key device was specifically in

January, 1911, although as early as 1906 it had occurred to him as an idea, and on many occasions before the order was made up on February 3, 1911. He then goes on to state that on January 26, 1911, he received an order from the Pacific Iron Works of McKittrick for an old style slotted Tee for 12½ inch Wilson under-reamer to be shipped by express; that the order was filled on that day, and that he was surprised to find that there was a reamer of that type still in use; that he had abandoned the use of the slotted Tee on account of the weakness of the Tee, it breaking through the slot; that he had depended upon a draughtsman whom he had employed when that reamer was first constructed to so apportion the Tee as to lay it out to the working size of the drawings as to give that Tee all the strength possible, but that the breakage of those Tees caused him to abandon the use of them and to go back to the block-and-screw type; so that this order received in January, 1911, again brought to his mind the possibility that there was merit in the Tee, and for the first time it occurred to him that it was barely possible the draughtsman had made an error in his dimensions and had not made the Tee as strong as it could be made; that Wilson went over to a draughting board and himself laid out one of the Tees of the slotted type, increasing its size and making it the size he had discovered when he commenced to work on it himself that it could be made; that he was surprised to find that it was fully twice as strong as those they had made; that he then made up his mind that he would go back to the slotted Tee type, using the larger pro-

portions; that with that idea thoroughly settled he checked up by comparing his figures with those of his brother's, they going over it very carefully *January 26, 1911*, and he then made up his mind that it was possible to make a single-piece key which might overcome a few of the minor troubles they had had with the double type key; that the idea he had back in 1906 and 1907 then occurred to him and he pondered over that idea. Pondered over that idea and keys three or four days, making sketches of them and thinking them over and studying them over at home, and could not determine in his own mind which was the better form of those keys to try out first in this new type of reamer; that he finally concluded one day to call some of the boys together and get their opinion as to which would be the better type of key, and that some time about February 1 or 2 or 3 he called some of the boys together and explained to them that he was going back to the slotted Tee type, having become satisfied that it was the best, and having discovered that he could increase the strength of the Tee so that that trouble could be settled and overcome, but that he was not sure which style of key he could use; that he then produced some little sketches which he had, which he had been thinking over, and said, "Here are the different ideas I have," and one of which would have to be held in with a plug and another one probably with two plugs, and one dispensing with the use of the plug at all, but with a key, and while he could see that it was stronger and probably more convenient to put in place, he was uncertain as to the best method of re-

moving it from the reamer when it was in place, the tension of the spring being very great and it being a particularly difficult matter to get the key out. Reproductions of these sketches he made are in evidence as "Defendant's Wilson Reproduction Sketch of Sketches of Late January and Early February, 1911"; that in the conversation, at which Mr. Wilcox, his brother, W. W. Wilson, and Mr. Bole were present, and he thought Mr. Knapp and Mr. Willard, he said, "Here is the best key. I can see that. It will stay in the reamer without the use of any plug at all, but we will have trouble to remove it"; that at that juncture Mr. Bole suggested to pry it out, but that he said, "Very well. We will admit that it can be pried out, but won't it give so much trouble in doing so that it will probably condemn it and drillers won't use it?"; that Bole said, "No; I can devise a tool that will pry it out"; that Wilson said, "I can devise a tool that will pry it out, but I think it will give us a good deal of trouble"; and that after further discussion the boys agreed with him that that was the better style of key and it was well worth trying, and that with that point settled they proceeded to make up a single-piece key as he desired, and that that was the genesis of the key, and that he had some little sketches which he put before these persons at the time mentioned, in February, 1911, "*which he had been carrying around for several days,*" and that it was in this way he submitted these ideas to these men for their consideration, and that he does not think he preserved these sketches at all, but that the key was probably made up from one of the sketches he

showed the boys at the time, one of the original sketches. The reproduction sketches in evidence were offered in the interference. The witness then tells the court what the various sketches represent [line 2, p. 104, to line 26, p. 112, transcript]. The witness then refers to a copy of a letter he wrote to Williams of the Pacific Iron Works at McKittrick on the day he received the order, namely, January 26, 1911, fixing the time of his commencement to work over the under-reamer to include the single-piece key [line 27, p. 112, to line 19, p. 115, transcript]. The witness also produces a letter which he received from Mr. Williams in response to his letter, the same being dated January 28, 1911, and which further fixes this time and is in evidence as Defendant's Exhibit Pacific Iron Works Letter of January 28, 1911 [line 20, p. 115, to line 25, p. 116, transcript]. The witness now identifies the parties Willard, Knapp, Wilcox, Bole and W. W. Wilson, who were present at the conference in the first part of February, 1913, about the key, W. W. Wilson being his brother, Robert E. Bole being the party for whom the company was then making pumps (Bole, complainant), C. E. Wilcox, a salesman, and Knapp, the foreman, and Willard, his partner in the defendant corporation [lines 27-8, pp. 116-117, transcript]. Witness also produces an order dictated by himself on receipt of the order from the Pacific Iron Works of McKittrick on January 26, 1911, the date of the shipment being the same day, the slips being in evidence as Defendant's Exhibit Pacific Iron

Works, January 26, 1911, Shop Order Slips [line 9, p. 117, to line 5, p. 118, transcript].

The witness then produces the shipping receipt of May 25, 1911, for the shipment of another under-reamer, 496, with a small lever attached, shipped to the Kern Trading & Oil Company at Kerto, California, May 25, 1911, a reamer commenced after reamer 120 was made over, the shipping receipt being in evidence as Defendant's Exhibit B [line 6, p. 118, to line 11, p. 119, transcript]. The witness then testifies [lines 12-8, pp. 119-120, transcript] that he received his knowledge of the single-piece key in issue from his own conception, and that subsequent to 1906 or 1907 and prior to the time he made preparations for making over reamer 120 he received from no other source any information or knowledge with respect to such single-piece key. *This is a clear denial that Bole ever conveyed any such information to him*; also that he had never seen such a one-piece key prior to the time last mentioned, or prior to February 3, 1911, and that, prior to February 3, 1911, he had never seen a cut or drawing or any descriptive matter disclosing any such one-piece key excepting those he had made himself; and that prior to February 3, 1911, no such single-piece key was ever described to him by word of mouth or otherwise by any other person [line 12, p. 119, to line 3, p. 121, transcript].

It is perfectly clear from this testimony, which is thoroughly corroborated, as we shall see, by Willard, W. W. Wilson and Wilcox, that Wilson definitely and finally conceived of this single-piece key in issue about

January 26, 1911,—*which is a day before the date of the Bole January 27, 1911, sketch*; that he made sketches of that key and several others within a few days of that time, and on or before the 3rd of February, 1911, he disclosed these sketches to Bole and Wilcox and W. W. Wilson at least, and that all Bole ever had to do with that key was the futile suggestion to pry it out, as reflected in the dubious January 27, 1911, sketch, and which suggestion was never adopted because Houriet showed how to pry the key up and drive it out. The defendant Wilson then goes on to testify that his business in under-reamers has run up to from 600 to 800 of them, and that probably two hundred of them were made with the one-piece key before February 19, 1913, when Bole applied for patent; and then produces blue prints showing the practice of the shop in making reamers with the key of the issue away back as early as May and June, 1911. The witness testifies that he has seen Wilson reamers in operation as early as the year 1911 [line 4, p. 121, to line 16, p. 124, transcript]. These blue prints or tracings of the same are in evidence as “Shop Tracings of May and June, of Wilson Under-Reamer with the Single-Piece Key.” The appellees conceded on the record that the appellants have been marketing the invention since June, 1911, and advertising and selling it, and that they had been successfully operating it as early as July, 1911 [lines 1-19, p. 128, transcript]. The witness then proves extensive circulation of booklets advertising the invention, several thousand of them being printed and mailed to different

oil companies throughout California and the eastern oil fields and foreign oil fields [line 4, p. 129, to line 29, p. 130, transcript].

All of this shows that Wilson was diligent in putting the invention into practice and selling it and advertising it, Bole not having been shown to have ever done any such thing at all. This testimony also speaks clearly for Wilson's independent act of invention of the issue of the patent in suit and for his disclosure to Bole instead of any disclosure by Bole to him, and shows a clear anticipation of the Bole patent by Wilson's manufacture and sale of the reamers and advertising thereof, and the use thereof, and leaves Bole with nothing but the figments of imagination attaching to his earlier alleged and abandoned invention of 1908 at Maricopa.

Upon the record there appears a letter [pp. 153-154] dated February 28, 1911, written to one J. A. Kibele, at Bakersfield, California, describing the new reamer with a single-piece key and prophesying what a success it would be and referring to the prying up of the key and the driving of it out. Of course the reamer had not been completed at that time, and what was stated was prophetic, but it shows the completion of the invention as far as Wilson's conception and disclosure and the commencement of reducing to practice are concerned. It must be remembered that the reamer with the key of the invention was not completed until at least in April, 1911, which was well within the two years permitted by the statute within which to file applications for patent, *and it was not incumbent upon Wilson to apply for that patent, as he did, in March,*

1913, until just before the expiration of the statutory two years, as he was vigorously asserting his right to the invention by manufacture, sale, and advertisement of it. With Bole the case was different. If he ever was in possession of the invention it was his duty to speak out to Wilson the moment Wilson commenced to use the invention and to apply for patent thereon without letting laches run against him and allowing Wilson's business good will and rights to pile up.

Complainants tried to tangle the witness Wilson with respect to his calling of the various parties together for the key conference above referred to. Whether or not they were singled out and invited separately or found together in a group in the shop is immaterial. The fact that they were gotten together is what is significant in the case as to this incident. It is our contention that the lengthy cross-examination of this witness fails to break down his direct examination. He shows on redirect examination that the question of prying the key out was probably repeated by Wilson several times during the course of the time that he moved about in the shop from place to place as he was discussing this matter, the parties walking around near the shipping desk and near the shaper in the shop [line 18, p. 193, to line 13, p. 195, transcript]. The witness testifies [lines 5-14, p. 197, transcript] that Bole never showed him any tool for prying the reamer key out. It is not claimed that he never showed him the alleged January 27, 1911, sketch either. The witness testifies that, in spite of Bole's uncorroborated testimony that he, Bole, had been working up a single-

piece key for a reamer, he, Wilson, did not know and was not told that Bole had been working on a single-piece key, but was only told Bole had been working on a lever for prying out the single-piece key. It will be remembered that Bole tried to make out that there was an earlier key made than that for reamer 120, and that he admitted that he was in error as to such incident.

The testimony of Knapp [pp. 199 to 219, transcript] fully corroborates Wilson as to his foremanship during 1911, as to the making of the first single-piece key in 1911 for reamer 120; that Ridgren, Berg and Houriet worked on it, and that *reamer 120 was made over under instructions from the defendant Wilson given to himself*; also that these instructions were verbal, Wilson taking him over to the side of the shop where reamer 120 was standing and explaining to him that he was going to try a one-piece key in the reamer, Wilson at that time taking a pencil and drawing on the palm of his hand a sketch of the key [lines 11-18, p. 201, transcript]. He then refers to former interference reproduction sketch of the key, in evidence as Defendant's Exhibit Knapp Single-Piece Key Reproduction. Knapp then goes on to identifying order 6904, and his receiving the same, and first seeing it February 3, 1911. He then describes the papers pertinent to this order 6904 and order 7056 dictated by himself and turned in by himself March 8, 1911. These slips show Knapp's initials, that he charged to the reamer account on order 6904 for the labor performed on that order [lines 6-10, p. 205, transcript]. He then

identifies the slips turned in by workmen engaged on that order, identifying also the times the slips were turned in. Knapp then testifies that to his knowledge Robert E. Bole, the complainant in this case, gave no instructions or assistance by act or word of mouth in connection with making over reamer 120 to include the single-piece key, which is the first single-piece key shown in this record to have been made for an under-reamer, and shown to have been made under the directions of E. C. Wilson, whom the Patent Office has twice found to be the inventor thereof. Knapp also testifies that Bole at no time submitted to him any sketch or drawing or outline of such a single-piece key prior to the completion of this making over of reamer 120 [line 16, p. 209, to line 10, p. 210, transcript], and also that he, Knapp, received no instructions as to the making over of this reamer 120 from anybody other than the defendant E. C. Wilson. Knapp further testifies as to the shipping of this reamer to the Norbeck & Nicholson Company in Dakota, placing the time as June, 1911. Knapp positively fixes Al. Houriet, the workman in the shop referred to by Wilson in this respect, as being the man who first took out, with the tang-end of a file, the single-piece key from this reamer 120, he being one of the machinists in the shop, and that Knapp saw him do it [line 17, p. 211, to line 16, p. 212, transcript]. At this point Knapp refers to the making of the outline of the key on the brown paper drawing which showed the Tee-bar that was used in reamer 120, making the same on April 22, 1911, for a shop record [line 17, p. 212, to line 6, p.

214, transcript]. Knapp clearly establishes this reamer 120 as the first to use the single-piece key, and also testifies that prior to the making over of this reamer 120 he had never seen or had any knowledge of an under-reamer containing such a single-piece key. Manifestly, Bole never had anything to do with this first key, and never knew of a single-piece key until this one was made [lines 7-21, p. 214, transcript]. The red marks on the brown paper sketch having the Tee and key are shown to have been made by Knapp in the office of the shop of the defendant corporation, and the key sketch was some month or six weeks after the key was completed, the notches shown in the key having been originally intended for using with a tool to pry the key up, but these notches having been abandoned after making not over one-half dozen of the keys for Wilson reamers, as they found it was not necessary to use them, for by driving a wedge-shaped tool underneath the key it would raise it enough so that you could drive it out. This brown paper sketch is specifically in evidence as Defendant's Exhibit Wilson Reamer Tee and Key Sketch of 1911 [line 23, p. 216, to line 24, p. 218, transcript]. The original reamer, fully proven as it is, and not controverted as to its manufacture, is not attempted to be introduced in evidence, and, having been shipped to South Dakota, was not available and doubtless could never have been produced, inasmuch as these reamers more or less rapidly wear out and are discarded for new ones. We have admissions as to the extensive manufacture and sale of Wilson reamers anticipatory of Bole, and the

record as to this reamer is so full and complete that there never has been any controversy with respect to its completion and shipment, nor can there be any controversy as to the details of its construction. The witness Knapp tells a clean, consistent, corroborative story, and is under no compulsion or influence of the defendants, as he was not in their employ at the time he testified. This witness testifies also that there was a lever shipped with reamer 120, the first single-piece key reamer, and that levers like it had been in the shop of the defendant company prior to that time, they having used a similar lever for raising the block and compressing the spring in the old-style block-and-screw type under-reamer, and it had been in the shop substantially a year and a half [line 27, p. 230, to line 20, p. 231, transcript]. It is manifest, as above pointed out, that Bole never invented even the lever that he says he attempted to perpetuate by the January 27, 1911, sketch.

Albert W. Houriet testifies in corroboration of Knapp and Wilson as to the making of the reamer with a single-piece key, that is, making over reamer 120, as early as the middle of February, 1911, and how he first tried to pry out the key, and that he then told the foreman, "I guess you don't need no lever to pry it out. Here is a simpler way to get at it"; that he took an old file there and drove that in and said, "You take the tang end of the file and drive it in, and then you can drive the key out," and that he told foreman Knapp about it after he found he could raise the end of the key that way; that he had never seen a sin-

gle-piece key like that driven out that way before, clearly showing that there was nothing to Naphas' testimony about Bole removing the key. He fixes the time as later than February 22, 1911, when he first drove the file under the single-piece key and raised it up and then drove it out [line 9, p. 473, to line 15, p. 477, transcript]. His testimony is not broken down in any sense, and is remarkable testimony for a machinist working in a shop and remembering back three or four years in the routine work of his mechanical experience. He testifies that he received his instructions for working on the single-piece key from the foreman, and thus we see Bole had nothing to do with it.

Fritz R. Ridgren, another witness, who worked on the single-piece keys for Wilson under-reamers, testifies that he made the first one in the early part of 1911. He is not now working for the Wilson & Willard Manufacturing Company, although he was then. He testifies that he got a sketch from someone, although he does not know who gave him the sketch, but there was a rough pencil sketch on a piece of wrapping paper handed to him. This must have been a sketch furnished by Wilson through Knapp, for the keys that he made in conformity to this sketch were all of the same thickness or strength as to any one size reamer, thus rebutting Bole's uncorroborated testimony as to his work on a thinner original key, which of course would have to be forged in the shop by Ridgren had it been made there, as Ridgren testifies there was nobody else that made any keys except him that

he knew of. Bole practically admitted he was in error as to this earlier key, as previously pointed out. Thus Ridgren carries the single-piece key matter back to the early part of 1911 [line 17, p. 687, to line 10, p. 690, transcript].

It is significant that this testimony of Houriet's clearly corroborates Wilson's and Knapp's as to the wedging up the key with a file in reamer 120, the first single-piece key, so that it could be driven out, whereas Bole stands all alone in his testimony that he took the file and took the key out, and that Houriet was present [lines 17-8, pp. 694-695, transcript]. Houriet is established as the man who pried up the key with a file, and not Bole. Bole is defeated in every attempt to intrude himself into this controversy as having had anything to do with the first key or any key of the single-piece type involved in the patent. Naphas is contradicted, and Bole is contradicted, and there is nobody to support Bole in these contentions.

The testimony adduced by the court in examining the defendant Wilson clearly shows how in error Bole is and how correct are Houriet and Knapp as to this incident of prying out the key [line 11, p. 669], to line 20, p. 700, transcript].

WILCOX, W. W. WILSON AND WILLARD FULLY CORROBORATE WILSON AS TO CONCEPTION, SKETCHES AND DISCLOSURE OF THE INVENTION OF THE PATENT IN SUIT IN THE LATTER PART OF JANUARY AND FIRST OF FEBRUARY, 1911:

Willard was fully conversant with reamer 120 and its making over to include the single-piece key, and identifies the shop order upon which this work was done, that being the first reamer having such a key, the first slotted tee as called for by the slips of the order for reamer 120 being made in the early part of 1911 [Qs. 94-115, pp. 317-320, transcript]. Willard clearly corroborates Wilson as to the events leading up to the designing of the heavier slotted tee-bar associated in time with the correspondence with Williams of the Pacific Iron Works of McKittrick, stating that Wilson said to him upon receipt of the letter from Williams of January 28, 1911: "Could it be possible that the slotted tee-bar—could it be possible to make the slotted tee-bar strong enough;" and it was about that time that Mr. Wilson was working at the board, the witness referring to Defendant's Exhibit Pacific Iron Works Letter of January 28, 1911 [Qs. 134-146, pp. 325-326, transcript], and that prior to the commencement of work upon shop order 6904 for making over reamer 120 he had never seen a sketch of a single-piece key for an under-reamer. Clearly, Wilson commenced to work up this single-piece key independently in the last week of January, 1911.

Charles E. Wilcox testifies that he was, by occupation, an oil-well driller, and had used under-reamers

and the like, and that he was connected with the defendant company from about the first of January, 1911, up until this year, having severed his connection with that company about the first of February; that he sold under-reamers, elevators and circulating heads for the defendant company; that he first saw a Wilson under-reamer having a single-piece key between the first of January, 1911, and the first of March at the defendant company's place of business; that he saw others of the same general construction, including the one-piece key, during the years 1911 and 1912 made by the defendant corporation; that he has seen such a Wilson under-reamer in operation; and that he first saw such a Wilson under reamer in operation along in 1911 in the California oil fields, seeing them lowered in the hole and removed from the hole, the cutters being changed, etc., permitting the casing to be lowered after the hole had been reamed (which is the intent in the use of an under-reamer); and that approximately fifty times he had seen such use and operation of the Wilson under-reamer during the years 1911 and 1912, and that they were successfully in use, the complainants not controverting such successful operation [lines 29-31, p. 240, transcript]. From this point he goes on to state that such a single-piece key for reamers first came to his knowledge, or that when he first heard about it, was when he heard Mr. Wilson discussing something in regard to a key *shortly after he got a certain letter from Mr. Williams of the Pacific Iron Works of McKittrick, California* [line 18, p. 242, to line 26, p. 243, transcript]; that he saw sketches of a key only a few days

after he heard little bits of conversation in regard to the letter, thus clearly corroborating Willard and Wilson about the letter of January 28, 1911, from the Pacific Iron Works at McKittrick; that E. C. Wilson and R. E. Bole and A. G. Willard were standing at a desk only a few days after he heard about this letter, such desk being used for a shipping clerk's desk, and he was standing about four or five feet from them, or six feet, or maybe ten; that Mr. Wilson had a sketch on a yellow piece of paper of a key similar to the one that is made now and used in the Wilson reamer, this being in the shop of the defendant company, the shipping desk being at the north end of the shop, or at the rear, and about eight feet, he would say, from the center of a door-way, and that there was a planer or shaper nearest that desk; that Robert E. Bole was one of the complainants in this case and Mr. Wilson one of the defendants in this case; that he had never since seen this sketch that Mr. Wilson had, to his knowledge, but that he has since that time attempted to reproduce the sketch he saw then during the taking of testimony in regard to the interference suit; and the witness, upon being handed a sketch entitled "Wilson's Exhibit Charles E. Wilcox Key Reproduction Sketch," dated June 19, 1914, states that was the sketch that he made at the time of the interference in reproduction of the sketch he saw Mr. Wilson hold in the shop at the time under consideration. This sketch is in evidence as Defendant's Exhibit Charles E. Wilcox Key Reproduction Sketch, and clearly shows the key of the issue; that this sketch he drew in trying to produce a sketch as nearly as he could from memory

of the one that Wilson had in his hand at the time at the shipping desk [lines 8-10, p. 246, transcript]; that he stood only a few feet from Wilson when he saw this sketch in Wilson's hands.

To interpose, Bole had free run of defendant's shop during 1911 and 1912. This clearly shows in the testimony of Willard given in the interference [Qs. 63-68, pp. 312-313, record], and he had full access to the records of the company and had the confidence of those in charge. In spite of all this confidential relation, he never protested to Wilson against Wilson's use of what he is now claiming was his key invention.

Wilcox further goes on to state that at the time of this occurrence Wilson, Bole and Willard finally turned around and away from the shipping desk and stopped right opposite him, and Wilson had a piece of yellow paper in his hand and a pencil, and said, "Oh, I know how to get it in there, but I don't know how to get it out," and Bole said, "Pry one end of it up and drive it out," and that they passed on out of his hearing and that is about all that he heard at that time [lines 28-9, pp. 247-248, transcript]; and that on the yellow piece of paper which he saw Wilson hold at that time there was a sketch of a key. The court asked the witness how he came to see this sketch, and he said that that would be the same as if a man came walking by here and stopped within two feet of him and was standing there talking about it, holding it that way in front of him, and he would look over and see it. The witness further states that W. W. Wilson and Knapp, foreman of the shop, were over by the

door, about five or six or eight feet from the desk, W. W. Wilson being a brother of E. C. Wilson; that about ten minutes would cover the period of time with relation to this group of people and this talk about putting a key in and prying it out and his seeing the sketch as he says he did. The witness then testifies as to the presence in the defendant's shop as early as 1910 of levers like Defendant's Exhibit 9 or Wilson Reamer Block-Elevating Levers, and that the same were used when they first commenced making the present type of reamer, in trying to take the key out with a tool something of the same order, and that he saw such attempts [line 2, p. 236, to line 21, p. 251, transcript]. This testimony we believe sounds and rings genuine and true, and we solicit the court's careful examination of it. The cross-examination of this witness is an attempt to impeach the witness by calling to his attention certain testimony given by him in the interference, but this attempt fails, and is merely an attempt to slur positive, clear testimony by mixing up slight dimensions of space and by splitting up moments of time, and only tends to strengthen the purport of the testimony, due to the rigid bearing up of the witness under such tactics.

It seems that after the reamer was quite extensively used through the different fields Wilcox heard Bole make a remark that Bole had devised the key, some time in the year 1912. This was doubtless due to Bole attempting to carefully lay a plan, which he did not bring to Wilson's ears of course, to subsequently mulct Wilson and his company of the amount

of his large indebtedness to this and then lay some claim, with all the strange animus of a debtor to injure his creditor, to being the inventor of this key because he had suggested prying it out, which never was a success but for which was substituted the wedging of the key up and the driving of it out [line 6, p. 242, to line 24, p. 264, transcript]. The succeeding testimony on the same page also shows that when Wilson and Bole and Willard turned away from the desk at the shop and Wilcox saw the sketch of the single-piece key and heard the statements of Wilson and Bole pertinent to prying out the key Bole did not have any sketch in his hand or hold it in any way so that he could see it.

Clearly, this was the time and this was the place and this was the manner at and in and by which Bole first heard of a single-piece key device for an under-reamer. He never had had anything to do with under-reamers except to sell a few on the account of Wilson, these reamers being made for Wilson by the Wilson & Willard Manufacturing Company. His attempt to intrude himself as a mere pryer-out of a reamer key and then claiming he was its inventor does not give him the shadow, even, of joint inventorship. A thing must first be invented, as Wilson invented this key, before it could ever be put into place or removed.

W. W. Wilson testifying, beginning on page 267, states that he first was connected with the Wilson & Willard Manufacturing Company in August, 1908, and that he became bookkeeper and in charge of the office

routine, and later on became superintendent of the shop, and in 1913 was made vice-president of the company. He states that work was first commenced on the first one of the Wilson under-reamers with the single-piece key shortly after the conference in the Wilson & Willard Manufacturing Company's shop at which the key was discussed, and that was in February, 1911 [lines 31-5, pp. 268-269, transcript]; that he fixes this time from an order which he has seen and also a letter received from Williams of the Pacific Iron Works in McKittrick which arrived on the 30th of January, the witness picking up Defendant's Exhibit Pacific Iron Works Letter of January 28, 1911; and that he saw that letter when it came in, E. C. Wilson showing it to him shortly after he opened it [lines 5-20, p. 269, transcript]; that the first time he heard about the single-piece key that is built into the Wilson under-reamers, or the first time he saw a key of this type or a sketch or any representation, was at the conference which he believes took place on the 2nd or 3rd of February, 1911, E. C. Wilson first mentioning the use of a single-piece key when he received the order for the old-style slotted tee-bar from Williams of McKittrick, the witness referring to Defendant's Exhibit 2 [lines 29-11, pp. 269-270, transcript]. He then goes on to state that on receipt of this letter from Williams of McKittrick the matter was taken up with the witness by his brother as to whether or not it was possible that the draughtsman who made up the drawings for the old two-piece key under-reamer made them as strong as they could be (pre-

sumably the parts as designed by the draughtsman); that he and his brother figured the matter out in connection with the under-reamers then in the shop and found that a much larger hole could be bored in the body which would make room for a large diameter tee-bar in which the slot would not weaken so seriously as did the old style two-piece or as did the slot in the tee-bar for the old-style two-piece slotted-tee reamer, or two-piece-key reamer; that they then went in on the draughting board that afternoon and figured out how big they could make these, and the witness figured up the area of the rod that they could put into the reamer, and, subtracting from this the area which would be taken out by the slot, he found that the remaining area was greater than the cross-section of area of the tee-bar then in use, so that they found they could place a tee-bar in that type with a form of ample strength; that E. C. Wilson then stated that that would be the reamer to make; and they both agreed that that was the reamer to make in the future, because the trouble with the old slotted tee under-reamer was the fact that the tee-bar broke, giving trouble; that the key matter was talked over *at that time*, but only indefinitely; that the witness, as he remembers it, asked Wilson whether or not he would use the same kind of key he used in the old reamer, and he said no, he was *going to get one up with a single-piece*, that he thought it would not give the trouble of wedging against the plug. That later on, the next day, he believes, or the day following that, his brother stated that he intended to write Williams and find out his opinion as to

whether a reamer using such a tee-bar and such a key would be easily assembled and disassembled and not give the trouble that had been occasioned by the sticking of the plugs in the block-and-screw type—if he did not think that would overcome the prejudice which drillers seemed to have against the Wilson reamer; that they found that drillers preferred the other type of under-reamer, although from their experience and their observations they believed that more breakages occurred with the Double under-reamer than with their under-reamer; that they could not understand this except from the fact that possibly the inconvenience of the plugs caused a prejudice on the part of the drillers or the men using those under-reamers; that this letter was written to Mr. Williams at McKittrick and on January 30 they received a reply from Williams [line 12, p. 270, to line 10, p. 273, transcript].

The witness then goes on to say that two or three days subsequent to that he was passing through the shop to the shipper's desk from the office to get some information in regard to a shipment of material received in the shop, and he believes he stopped and talked with Knapp a few moments about some matter; that then it came to his attention that Willard and Bole and E. C. Wilson and Wilcox were standing near one of the shapers, near the back shaper in the shop, looking at an under-reamer which was lying on the floor, and so he stepped up to the conference and saw there his brother had a sketch on a piece of paper, or several sketches on two or three pieces of paper, showing different types of keys, and explaining that

he did not want to use the old two-piece key but that he had gotten up several different designs of key that could be used in this reamer, one of them being retained by a single plug and another by a countersunk-type plug similar to that used on the old two-piece key under-reamer, and another consisted of a plain bar of iron with a bevel at one end, with a plug at each end of the key to hold it in place, and another of a bar of iron or straight piece of iron with one end beveled and the wings projecting down; that these were hooks with a vertical side and an inclined side to them; that Wilson said that this one could get into the reamer but he didn't see exactly how to get it out, and Bole stated, "pry it out," and he believes Wilcox added, "Yes, pry it out," and that the general concurrence of opinion at that time was agreed on that it could be pried out of the reamer. He then goes on to state that the topic of conversation then took the form of a discussion of the methods of prying it out, and he then stepped over to the shipping desk and got his information and, he believes, returned back to the office. The witness goes on to further state that subsequent to this time an order was gotten out which he saw at the time in the shop to change over an old under-reamer they had there and put in the new type of key and also the enlarged tee-bar as they had figured out; that the work was begun on that order, and that that reamer was finished up in the shop in this manner and was later on sold to Norbeck & Nicholson Company and shipped to Dakota, and they never heard any objection to the under-reamer, or heard of it, particularly,

since, and that it was paid for by the Norbeck & Nicholson Company. That Bole was the first one that said, "Pry it out," and he is sure Wilcox was present at the time, and that this discussion about prying out the single-piece key took place in the shop of the Wilson & Willard Manufacturing Company within eight or ten feet of the shaper furthest from the office in the shop, there being a shipping desk at that end of the shop, and the conference or talk was about eight or ten feet from the shipping desk, and that he has not seen the sketch or sketches which his brother had at that time since the occurrence. He then identifies the reproduction sketch made by him in the interference suit and which he states, as he remembers, is the key that Mr. E. C. Wilson was explaining—the key sketch that Mr. Wilson was explaining at this conference of February 2, or 3rd, 1911, this sketch being in evidence as Defendant's Exhibit W. W. Wilson Key Reproduction Sketch. He identifies order 6904 for changing over the under-reamer shortly after this conference, and other parts of Defendant's Exhibits 6, 7 and 8. At this point complainants admit that they do not controvert the question of time of a slip of the order referred to [line 10, p. 273, to line 13, p. 278, transcript]. The witness then goes on to testify as to the carrying out of the work in the shop pursuant to order 6904 and the associated order 7056, it being admitted by complainants that Knapp was foreman of the shop and had charge of the work. The witness testifies on examination by the court that his brother gave all the orders with regard to the construction of

this reamer [lines 30-32, p. 279, transcript] and that he saw that reamer assembled, with the key in place, and that he saw the reamer disassembled and the key removed after the parts had first been put together, further corroborating the testimony of Wilson, Knapp and Houriet as to Houriet first driving the tang of a file under one edge of the key and prying it up, and Houriet was then able to drive the key out on the other side. He also distinguishes between this key and the lever of the Defendant's Exhibit 9 [line 14, p. 278, to line 31, p. 280, transcript]. The witness also further testifies as to this. This witness is not weakened on cross-examination, and certainly his testimony establishes the fact that Wilson devised this single-piece key in the last week of January, 1911, made sketches of it shortly afterward, and shortly afterward disclosed it, to Wilcox and to Bole and himself at least, at the rear of the shop of the Wilson & Willard Manufacturing Company, and that reamer 120 was immediately thereafterwards put into process of production and completion, or making over, and when completed was shipped to the Norbeck & Nicholson Company. The proofs are full and complete as to conception, disclosure and sketches and immediate diligence on behalf of Wilson in respect to this invention, and there is no scrap of evidence to show that Bole had anything to do with it except to suggest that the key be pried out, which was a method of removing the key which was not followed, but, rather, the method devised by Houriet.

COURT'S INSTRUCTIONS AGAINST EVIDENCE.

It is to be pointed out here that the court, as shown in lines 20-13, inclusive, pp. 290-291, barred proofs which appellants contend would be proper as to this important question of priority and originality as between Wilson and Bole.

REPRODUCTION SKETCHES OF WILSON SINGLE-KEY
SKETCH OF CONFERENCE ABOUT FEBRUARY 1,
1911.

In addition to the Defendant's Exhibit Charles E. Wilcox Key Reproduction Sketch, there is Defendant's Exhibit W. W. Wilson Key Reproduction Sketch, both of which show the single-piece key of the issue, and reflect what these witnesses say the defendant Wilson had in sketch form and disclosed to them and to Bole at this conference. This all is the unequivocal, positive and confirmatory evidence of Wilson's disclosure. And it will be remembered that there was a Wilson reamer present and that all these parties were thoroughly conversant with the Wilson reamer, making the disclosure full and complete, and this is the first believable testimony we have as to any disclosure of this invention by either Bole or Wilson to anybody else. This is true, among other reasons, because the testimony rings true, and furthermore because Wilson followed up this disclosure with industry and diligence in and about reduction to practice—something that Bole never did at any time.

The foregoing analysis of the record in this case

must make it exceedingly plain that the Bole patent is absolutely void because of anticipation by the Wilson admitted diligence, manufacture, sale, and use, together with the extensive circularization of the trade as to the same, many months before Bole filed his application for the patent in suit, and going back in fact to a time substantially twenty-two months before Bole applied for such patent.

BOLE PATENT ADMITTEDLY INVALID FOR ANTICIPATION
UNLESS BOLE BE FOUND TO HAVE PROVEN HE
DISCLOSED THE INVENTION TO WILSON PRIOR TO
JANUARY 26, 1911.

On this score there can be no doubt under the law, for the making and selling of a single specimen, or knowledge of another of a single specimen, of a patented thing, prior to the date of the patent, if such making and selling was performed by any other than the inventor, or the knowledge came not from the inventor, will absolutely defeat the patent date unless the patentee can show an earlier date of invention. If it be assumed that Bole was in possession of the invention in September, 1908, unless he prove that he disclosed it to Wilson before Wilson came into possession of the invention, Bole's asserted rights must absolutely fail for want of diligence, no explanation being given why he never reduced the invention to practice or had it reduced on his behalf, or applied for a patent, until February, 1913. By all equity, requiring him to speak out and assert his right if he had the invention—and which he did not do during all that long period of time

he witnessed Wilson's right to the invention and to the practice of it—Bole is barred from claiming any right of the patent in issue.

So Bole must prove that he had the invention before Wilson did and that he disclosed it to Wilson, in order to win in this suit. Coming right down to the specific issue, we wish to present on the record, Bole must prove that he disclosed this invention to Wilson before January 26th, 1911, in order to prevail on this appeal. Even then, it is a question whether his patent can be found valid, due to his laches and his failure to assert his rights and file an application until he had permitted Wilson to incorporate in the good will of his business his (Wilson's) assertion of his right to this invention.

As a matter of fact, we contend that Bole never had the invention prior to the time it came into the possession of Wilson through his own conception thereof, but that, on the contrary, Wilson, being the originator of the invention, disclosed the invention to Bole on or about the 3rd of February, 1911, and Bole never did anything in and about the invention other than to make certain useless explanations about prying out the key, and then surreptitiously applied for a patent some two years after.

So we contend that Wilson must prevail in any event, because,

First. That the activity of himself and the defendant corporation in practicing the invention absolutely invalidates the Bole patent in suit in anticipation.

Second. That Bole, even if in possession of the invention before Wilson was, never disclosed the inven-

tion to Wilson, and that, therefore, Wilson was an independent and original inventor.

Third. That Wilson, so being an independent and original inventor, disclosed the invention to Bole and gave him all the information about the invention which he utilized in applying for the patent in suit for the invention; Bole never theretofore having any knowledge whatsoever of the invention or in any manner being in possession thereof; that if Bole was in possession of the invention before Wilson, he never disclosed the same to Wilson, and is not a prior inventor because he lost his rights through laches and want of diligence to reduce his invention to practice and even to apply for a patent until his rights were barred by the diligence of the independent and original inventor Wilson, who, upon all of the rules and authorities, must be found the prior inventor, as well as the original inventor, of the issue of the patent in suit.

Therefore, we repeat, that unless Bole has proven in this case that he disclosed the invention to Wilson before January 26th, 1911, or before the conference of about February 3, 1911, defendants in any event must prevail on this appeal.

And there is not one faint color of any evidence in this case other than the unsupported and contradicted word of Bole to tend to prove that Bole did so disclose the invention to Wilson.

And can this unsupported assertion of a discredited, animus-actuated man, who mulcted the plaintiffs out of substantially \$5,000 in a settlement, and flew to Wilson's competitor, prevail as against the proofs

and admissions of this case in anticipation of the Bole patent by Wilson's activity, Wilson's disclosure to Bole, and Wilson's independent procedure and diligent activity in and about the invention?

Whatever singular and improperly presented fragmentary doings there were back in 1908 at Maricopa, they produce no controlling presumption as to what Bole did in the shop of the Wilson & Willard Manufacturing Company in 1911. The appellee Bole, who was trapped in his deceitful attempt to make out the case of the production of an earlier reamer for the single-piece key than the reamer number 120, is not to be believed when he tells us that he told Wilson about this invention, and when Wilson denies it, and when he fails to even attempt the corroboration through Naphas, which he said was possible, and when this same conspirator appellee is denied and unsupported as to his assertions, not only by Wilson, but by Fahnestock and Grigsby, and Bole's friend Willard, and whose own witness Naphas has shown, by words out of his own mouth, to have been absolutely in error as to the things he testified about, because of his specific false fixing of the time in evidence.

Of course, Bole denies the disclosure by Wilson to him at the February conference, and denies the waiver of any claim to the invention and covenant not to injure Wilson in and about the invention in February, 1913. This is to be expected.

Bole is estopped by his covenant of February 1, 1913, in the settlement with the appellant corporation, in which he agreed in fact never to assert any claim as to

the invention or make any trouble about it for the appellants. This was a covenant for the benefit of the Wilson corporation, as the appellant corporation was making these reamers for Wilson and entered into the terms of the settlement. Bole got his cheap settlement for one reason, because of this covenant, even if it entered only minutely into consideration, in passing from Bole to the appellant corporation. This was no recognition by Wilson of Bole's claim, but is a covenant by Bole to withdraw the claim and never to again assert it and never, under any circumstances, to harm this appellant corporation by such claim or by anything growing out of such claim. So, if the discredited Bole is faintly or in any measure believed as to his disclosure of his invention to Wilson, he is estopped and barred by all equity and good conscience from asserting any claim to said invention, and, of course, the claim of the other appellee, Double, his co-conspirator in this attack upon the appellants' claim, must likewise fail. We, therefore, in this case have the slender foundation for the appellees' claims comprising an unsignifying postal card of 1908, and the unsupported word of a discredited party to the suit, into which eats the corrosion of this estoppel with respect to the appellees asserting any claim in and about this invention as against the appellants.

ENIGMA OF THE TRIAL JUDGE'S FINDINGS.

How, with these facts before the trial judge, he could reach the remarkable conclusions of the opinion verbally rendered will, it is believed, be a matter of extreme con-

jecture on the part of this court; how the trial judge could excuse Bole from perjury, because he did not appear to be perjuring himself in a more extensive or conventional manner; how such element of perjury, if it entered into the case, was not controlling on the case; how Wilson could be found wanting in diligence equally with Bole when Wilson was vigorously asserting his invention and flooding the oil well fields with reductions to practice thereof, while Bole was running up a debt to Wilson and never asserting any claim to the invention; and how he could find that Bole had no opportunity to apply for a patent unless the appellants should try out the invention when the appellants showed their eagerness to adopt the invention as soon as Wilson originated it, and would doubtless gladly have paid Bole a royalty for this invention or bought the invention outright, if Bole had produced it, and been a man of honor enough to have treated with his friends rather than with his friends' enemies; how the court could have put any faith in the January 17, 1913, letter of Bole asserting, for the first time, to Wilson, Bole's claim in and about the invention, after Wilson had been practicing the invention for nearly two years, and in view of the fact that Bole was desperately in debt to Wilson's company; how the trial judge could find that it was a very unnatural and unusual thing to make a settlement with Bole without including in that settlement the controversy concerning the key, when Wilson attempted to explain to the court his procedure in these respects, and the court cut him off with the ruling that such statement of the reasons for that settlement was

immaterial;—how, in fact, there could be found to be anything sacred and holy about the patent in suit because it had been issued by a tribunal operating in total ignorance of the equities against the patentee and in favor of Wilson, when the patent was issued, and which tribunal, the Patent Office, upon becoming cognizant of Wilson's side of the story, has twice decided in favor of Wilson as to priority and originality of invention—all these things are beyond understanding; and, out of our high respect for the trial judge, we have only to say that the findings of the lower court reflect a confusion incidental to the first trial by a judge of a patent suit and which this Honorable Appellate Court is solicited to resolve into order and legal correctness. A review of the overwhelmingly controlling law on the facts supporting appellants' contentions will now be presented.

Authorities and Conclusions.

As to anticipation being a controlling defense in this case by proving want of novelty in Bole, the invention, having been practiced by Wilson prior to the date of Bole's application, Sec. 4920 of the Revised Statutes is warrant, without further showing to this court. Sec. 4886 permits the actual inventor to use the invention up to two years prior to the time of his applying for a patent; but the making of a single specimen of the thing patented by another prior to the date of application for patent, unless the patentee has disclosed his invention to such other, operates to negative novelty, as see Walker on Patents, Sec. 72, page 67.

Sec. 4920 likewise provides for the interposition of other defenses relied upon, namely, that Bole was not the original and first inventor or discoverer of any material or substantial part of the thing patented, and further, that he surreptitiously and unjustly obtained the patent for that which was in fact invented by another, Wilson, who was using reasonable diligence in adapting and perfecting the same, and who applied for letters patent for the invention in evidence twenty-seven days after Bole filed his application, and well within the two years permitted to Wilson by statute to practice his invention prior to such filing. The application is only constructive reduction to practice, and this is all that Bole has in the case. Wilson has behind him the actual reduction to practice indulged in for nearly two years before the constructive reduction to practice by Wilson consisting in filing his application involved in the pending interference in the Patent Office with the Bole patent in suit.

The present suit is brought under Sec. 4921 of the Revised Statutes, involving the patent issued to Double and Bole on an application filed by Bole, and which patent, as above pointed out, has twice been found by the Patent Office to cover an invention originally and independently and first produced by Wilson, the appellant. These applications are found to have been co-pending eight months, and, therefore, any interference should have been declared as between the Bole and Wilson applications before the issuance of the Bole patent, under Sec. 4904 of the Revised Statutes. Had such

interference been declared while the applications were co-pending the patent of Bole would never have issued, as yet at least, inasmuch as the Patent Office has twice found Wilson to be the inventor, and not Bole. It was through inadvertence or carelessness of the Patent Office that there was not timely declaration of such interference and that the Bole patent was permitted to issue, so that the interference had to be declared between the issued Bole patent and the still pending Wilson application, allowing this unwarranted monopoly to issue forth in favor of Bole from the portals of the Patent Office for the persecution of Wilson and his company, as put into effect by the filing of the present suit and the damaging assertions in the field and trade made possible by the wrong issuance of such patent to Bole, and to the effect that Bole, and not Wilson, was the inventor of that asset of Wilson's business, a factor of Wilson's good will, consisting of the invention in issue.

BURDENS WHICH MAY BE IMPOSED UPON WILSON
DUE TO THE CARELESS AND INADVERTENT ACTION
OF THE PATENT OFFICE.

If a patent should issue to Wilson pursuant to the deliberations of the several tribunals of the Patent Office which hear interference contests, a further proceeding may be necessary to be established in the Federal Court under Sec. 4918 for cancellation of one, either the Bole or the Wilson, patent. Furthermore, if a patent is refused to Wilson, he may bring an action in the Federal Court under Sec. 4915, Revised

Statutes, to authorize the issuance of a patent to Wilson. It will be seen that this suit is within the jurisdiction of this court with respect to infringement of the patent issued to Bole, in a forum of the same order and class as the Patent Office, and the Appellate Court above it, on the questions of priority and originality of invention at least, the jurisdiction of this court on the question of cancellation of one of two interfering patents, on the question of authorizing the issuance of a patent to an unsuccessful inventor, being grounded in sections of the statute of no higher order or greater scope and authority than sections which provide for the determination of interference contests in the Patent Office. And the jurisdiction of this court in this suit is under a section of the statutes of similar order, as well as are the defenses of this suit presented under a section of similar order, all of such five sections of the statutes being closely grouped together and necessarily interrelated for purposes of providing for justice in determining issues of infringement and issues of priority and originality of invention as between inventors, *and particularly as between inventors which are parties to the same litigation.* It is only natural, therefore, and to be expected, that the Patent Office tribunals are to receive close attention by the Federal Courts as to their findings on questions of fact. That their findings are so highly persuasive upon this court in an action pertinent to the right to patent on originality or priority of invention was early settled, and this doctrine has persisted ever since and is a doctrine apparently totally ignored by the trial court in this case. And at

this point we wish to assert that appellants laboriously and diligently and exhaustively set forth, and offered further to set forth, the law in this and other leading respects upon the trial of this case, in order that the trial judge might, in this, his first patent suit, have our respectful offer of assistance to familiarize himself with what we believe he admitted was, to him, a radically new department of jurisprudence.

This viewpoint as to accrediting the tribunals of the Patent Office forum and the appellate federal tribunals next above the same, namely, the Court of Appeal of the District of Columbia, upon the findings of fact pertinent to originality and novelty and priority of invention arrived at in such federal forum, inclusive of the Patent Office and such appellate tribunal above the same, and which has crystallized and become consolidated into a strong and far-reaching doctrine, is based upon good sense and reason, inasmuch as this Patent Office forum is specially organized and expertly organized for the considering and the ruling upon contests of this order, whereas the various Federal Courts of the nine circuits are not in any manner or any instance so peculiarly specialized and equipped unless we find such equipment and specialization reflected in the learning and ability of a judge who, as a matter of accident, is particularly versed in the law of patents and the laws of mechanics, and brings to the performance of his judicial functions qualifications in these respects which apparently are not deemed of any controlling value determining the selection of federal judges. In other words, a judge who pre-eminently

must pass upon the vast amount of litigation involving the United States of America as a party, and involving bankrupts and violators of the law, criminally and civilly, in many diversified branches of the practice in the Federal Courts, cannot be presumed in any instance to be chosen to fill his office because he is a good patent judge before taking office. Therefore, the Patent Office should be given a widely open ear by the Federal Courts as to its pronouncements on these questions of fact pertinent to priority and originality of invention as between contesting claimants.

This doctrine under discussion was early announced in *Shuter et al. v. Davis et al.*, 16 F. R. 564, in which it was said:

“The defense that Mark Davis was the original and first and original inventor of the patent improvement, that complainants obtained the patent in fraud of his rights, supported by some impressive probabilities on the testimony of several witnesses, is met by strong opposing proofs on the part of the complainants. Under the circumstances the presumption arising from the grant of the patent to the complainants is not sufficiently overthrown, and must prevail. But it also appears that the defendants were parties in a suit to interference proceedings before the Patent Office between the complainants and Mark Davis; that proceeding having been set on foot by Mark Davis for the benefit of the defendants to protect them from the complainants’ patent, and under the agreement between him and the defendants, by which the defendants undertook to pay, and pursuant to which did pay, the expenses of the pro-

ceeding. The question of priority having been determined in favor of the complainant in that proceeding, it is *res adjudicata* as between the parties to it.”

See:

Handfort v. Westcott, 16 O. G. 1181 (Official Gazette of Patent Office);

Greenwood v. Brocker, 170 F. R. 857;

Beck v. Lindsey, 2 F. R. 688;

Holliday v. Pickhart, 12 F. R. 147.

This extreme view has become somewhat modified, and, while the decisions of the Patent Office on questions of originality and priority are not now held by the authorities to make the matters in controversy *res adjudicata*, nevertheless, they go so far as to say that such decisions are to be followed, *unless convincing proof to the contrary is adduced*. This puts the burden of proof upon the complainants in the case at bar.

Walker on Patents, the leading textbook authority on the subject of patent law, quoting from Sec. 142, page 128, says:

“No decision of the Commissioner of Patents or the Court of Appeals of the District of Columbia, in any interference case, is pleadable as *res adjudicata* in any action in any court; but such a decision will be followed by all the courts, unless it is shown to be wrong by evidence which puts the point beyond a reasonable doubt. * * * If, in such a case as that under present consideration, it had happened that the successful applicant had filed his application before the interfering

patent was granted, that patent would not have been granted at all unless the Patent Office decision on interference had been reversed by some higher authority. In that event, the successful applicant would not have been liable to any interference suit, nor any infringement suit brought against him by his rival; for his rival would in that event have no patent upon which to base a suit of either of those kinds."

The Patent Office interference proceeding has been decided on behalf of Wilson, and he *did* file before the Bole patent was erroneously granted, and some eight months before that time, which has, as above pointed out, shown that the Bole patent in suit should never have been issued at all. Had this interference proceeding been decided as it should have been prior to the issuance of a patent to Bole, such patent would not have been issued at all unless the decision had been reversed, and this suit could not yet have been brought. The high importance of the action and power of the Patent Office with respect to the determination of questions of interference is thus seen. As the matter now stands, Wilson has been subjected to many thousands of dollars of expense in and about this issue of invention and infringement, absolutely unwarranted by a full observance of the statutes and authorities. Not only was the Patent Office derelict in the performance of its duty for many months as to the declaration of interference between Bole and Wilson, but when that forum had found in favor of Wilson, the trial judge in this case refused to follow its findings, and, upon a record remarkably devoid of any corroborative or

convincing proof, added to Wilson's woes and financial burdens by in effect reversing the findings of the Patent Office and necessitating the heavy expense and labor of this appeal. As the matter now stands, unless the decision of the Board of Examiners in Chief in the Patent Office is reversed, the patent will be issued to the defendant Wilson covering the same invention as that of the complainant Bole, and Wilson may bring his proceeding under Sec. 4918 in the lower court to cancel the patent to Bole. If, on the other hand, the decision of the Patent Office is reversed and Wilson does not prevail on appeal, he may have his remedy by a bill of equity in that court under Sec. 4915 for decree that Wilson is entitled to receive the patent for his invention and authorizing the Commissioner of Patents to issue such patent. So closely, as previously pointed out, are the functions of this court interrelated with the functions of the Patent Office, under Secs. 4921, 4918, 4915, 4904 and 4920, that it is impossible for a court such as this to pass properly upon the validity of letters patent where the question of originality or priority of invention is concerned, without taking notice of, and giving an open ear to, the deliberations and findings of the Patent Office under Sec. 4904. To fail so to do is to plunge a contestant on the question of priority or originality of invention into a multiplicity of contests and appeals therefrom, in concurrent jurisdictions, which can lead to only one ultimate and final solution, namely, an appeal to the Supreme Court of the United States, to straighten out such tangle as between such jurisdictions, which, instead of mutually

working to a common end, are, in this case, operating in conflict each with the other to the prejudice, peril, expense and bewilderment of the appellant Wilson. The record of this case in the lower court shows that it was solicited to stay the proceedings in this suit pending the determination of said interference in the Patent Office, but that even such motion was denied, and the appellants were forced to go to trial on an issue which, under the authorities, was most properly to be decided by the Patent Office, and which was so decided in favor of Wilson a few days before such trial began.

Further on this doctrine of Patent Office recognition on this matter of originality and priority of invention, let us turn to another text writer, Robinson on Patents, who more emphatically pronounces this rule in Sec. 1024, pages 255-257:

“Where this question of priority of invention has already been decided in an interference proceeding, the record of that judgment is admissible in favor of the then successful party, and, even though not conclusive on the jury, is entitled to grave consideration.”

It will be seen from this that the record of a judgment of the Patent Office under the Bole interference proceeding was properly admissible in this proceeding in favor of the successful party Wilson; and as to this Walker, *supra*, says, in the second paragraph of Sec. 318, page 282:

“A properly authenticated copy of a decision of the Commissioner of Patents in such an inter-

ference, or of the Court of Appeals of the District of Columbia, reviewing such a decision of the commissioner, is admissible in evidence in an interference suit between patents on inventions which were involved in such an interference.”

Because of the authorities, the introduction in this case of a certified copy of the decision of the lower tribunal in the Patent Office, which is, until reversed, the finding of the Patent Office in this controversy on priority irrespective of the pendency of any appeal, is, as to one of the defenses in this case, properly admissible in evidence, as is likewise, as a corollary proposition, a certified copy of the opinion of the Board of Examiners in Chief in the Patent Office, affirming strongly the opinion of the Examiner of Interference in the Patent Office, and which is respectfully offered for the consideration of this court on the argument of this appeal. And likewise, as a corollary proposition, we offered a certified copy of the Wilson application involved in the interference, decided in favor of Wilson, as admissible in evidence in this case with the other paper pertinent to the pendency of the interference. It is part of our defense that Wilson was the prior inventor as well as the original inventor, and, in order to make him out as such, his diligence will be shown as material, in contrasting the same with the lack of diligence of Bole in connection with the hypothesis that he was an independent and prior inventor; and, therefore, the applications lodged in the Patent Office by these parties and the dates and data pertaining to such lodgments are further material to the determination of this controversy.

A leading case on this doctrine of the influence of the decisions of the tribunals of the Patent Office upon the courts with respect to a controversy involving priority of invention (and priority must always include originality, for lack of originality will, of course, defeat a claim of priority, although the element of originality is not always specifically within the controversy), is that of *Morgan v. Daniels*, 153 U. S. 120. In that case, decided by the Supreme Court of the United States April 23, 1894, the Supreme Court supported the findings of the Examiner of Interferences in the Patent Office after three reversals, and the syllabus states:

“When a question between contending parties as to priority of invention is decided in the Patent Office, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction.”

Further excerpts from this decision are as follows:

“What, then, is the rule which should control the court in the determination of this case? * * * The plaintiff in this case, like the defendant in those cases, is challenging the priority awarded by the Patent Office, and should, we think, be held to as strict proof. In the opinion of the court below the rule is stated in these words: ‘The complainant, on the issue here tendered, assumes the burden of proof, and must, I think, as the evidence stands, maintain, by clear and undoubted preponderance of proof, that he is the sole author of

that drawing.’ 42 Fed. Rep. 451. * * * The case as presented to the Circuit Court (under Sec. 4915) was not that of a mere appeal from a decision of the Patent Office, nor subject to the rule which controls a chancellor in examining a report of a master or an appellate court in reviewing findings of fact made by the trial court. There is always a presumption in favor of that which has once been decided, and that presumption is often relied upon to justify an appellate court in sustaining the decision below. Thus, in *Crawford v. Neal*, 144 U. S. 585, 596, 12 Sup. Ct. 759, it was said: ‘The cause was referred to a master to take testimony therein, “and to report to this court his findings of fact and his conclusions of law thereon.” This he did, and the court, after a review of the evidence, concurred in his findings and conclusions. Clearly, then, they are to be taken as presumptively correct, and, unless some obvious error has intervened in the application of the law, or some serious or important mistake has been made in consideration of the evidence, the decree should be permitted to stand.’ * * * *But, this is something more than a mere appeal. It is an application to the court to set aside the action of one of the executive departments of the government. The one charged with the administration of the patent system has finished its investigations and made its determination with respect to the question of priority of invention. That determination gave to the defendant the exclusive rights of a patentee. A new proceeding is instituted in the courts—a proceeding to set aside the conclusions reached by the administrative department, and to give to the plaintiff the rights there awarded to the defendant. It is something in the nature of a suit*

to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence. *Butler v. Shaw*, 21 Fed. Rep. 321, 327. It is a controversy between two individuals over a question of fact which has once been settled by a special tribunal, entrusted with full power in the premises. As such it might be well argued, were it not for the terms of this statute, that the decision of the Patent Office was a finality upon every matter of fact. In *Johnson v. Townsley*, 13 Wall. 72, 86, a case involving a contest between two claimants for land patented by the United States to one of them, it was said: 'It is fully conceded that when those officers (the local land officers) decide controverted questions of fact, in the absence of fraud, or imposition, or mistake, their decision on those questions is final, except as they may be reversed on appeal in that department.'

"Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. * * * The question of priority is doubtful, and, if doubtful, the decision of the Patent Office must control. * * *

"It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in awarding priority of invention to the defendant; and because of that fact, and because of the rule that controls suits of this kind in the courts, we reverse the judgment. * * * ."

Here, as in the present case, the defendant had been awarded priority of invention, and the findings of the Patent Office on priority of invention were followed by the court in its instructions to dismiss the bill, and, as we see, the findings of the Patent Office were held to be the findings of a special tribunal intrusted with full power in the premises, as under Sec. 4904, and whose findings might well be argued to be a finality upon every matter of fact were it not for the special provisions of the statute (as under Secs. 4915, 4918 and 4921).

This decision has been cited and followed very frequently and is believed still to state the law as propounded by Mr. Justice Brewer of the Supreme Court in 1894. A number of such later authorities will now be adverted to, these authorities bringing the ruling up into close coincidence with the decision above referred to in the early case of *Shuter v. Davis*, 16 Fed. Rep. 564.

In *Standard Cartridge Company v. Peters Cartridge Company*, 77 F. R. 630, decided in 1896, the first syllabus is as follows:

“In proceedings, under Revised Statutes, Sec. 4915, by a defeated contestant in interference proceedings to establish a right to a patent, the decision of the Patent Office upon the question of priority, is to be taken as presumptively correct, and the burden is on the complainant to establish his case by testimony of a character which carries thorough conviction.”

69 Fed. Rep. 408, affirmed.

The opinion, delivered by Judge Lurton, later of the Supreme Court, commences as follows:

“Though the issue is one of priority of invention between Charles Hisey and George Ligowsky, its solution under this proceeding does not depend upon the mere preponderance of evidence. That department of government charged with the duty of originally hearing and determining questions of priority arising under conflicting applications of inventors has, upon evidence and full consideration, determined the controversy between those parties against the contention of the present complainants, and awarded a patent to the assignee of George Ligowsky. But for the provision made by congress, and found in section 4915 of the Revised Statutes, the conclusion of the executive department of government that Hisey was not entitled to a patent upon improvements which he claims to have invented in cartridge loading machines, would be fatal to his claim.”

See also first and third paragraphs, page 636, in which it is seen that new evidence, cumulative in nature, was added to the trial of the case, over and beyond the record upon which the Patent Office decision is based, similar to the situation here.

See also end of last paragraph, page 655:

“On the whole case, however, we lean to the correctness of the judgment of the Circuit Court and the action of the Patent Office.”

See also *Thomas & Sons v. Electric Porcelain & Manufacturing Company et al.*, 111 Fed. Rep. 923, first syllabus and second and third paragraphs, page 929,

in particular, the ruling in *Morgan v. Daniels* being again reasserted and relied upon.

See also the leading case of *Ecaubert v. Appleton et al.*, 67 Fed. Rep. 917, first syllabus and last paragraph, page 919, first and last paragraphs, page 921 *et seq.*

See also *Greenwood et al. v. Dover et al.*, 194 F. R. 91, first syllabus, and on page 91 as to appeals from the Patent Office in interference in questions, first paragraph on page 95 referring to conclusion in *Morgan v. Daniels*, second paragraph, page 95, as to additional evidence, last paragraph on page 94, particularly, showing the weight of the decisions of the Patent Office and the rank thereof, and the procedure therein, in interference matters, and the third paragraph on page 97 as to the burden upon the losing party in any interference proceeding.

See also *Computing Scale Company v. Standard Scale Company, Limited*, 195 F. R. 509, decided April 2, 1912, particularly the last paragraph on page 915, showing that an interference award deciding priority should be adopted by the courts as to litigation by the same parties unless there is thorough conviction to the contrary, reaffirming the doctrine of *Morgan v. Daniels*.

See also *Hilliard v. Remington Typewriter Co.*, 186 F. R. 344, decided 1911, first syllabus showing that the burden of proof is on the complainant to prove the Patent Office decision on priority is wrong.

See also page 336, last paragraph, in which the doctrine of *Morgan v. Daniels* is once more pronounced, and also see *Wire Book Sewing Machine Co. v. Stevenson*, 11 F. R. 155, with respect to the burden of proof of priority; *Lang v. Twitchell-Champlin Co.*, 207 Fed. Rep. 363; *Novelty Dredge Manufacturing Co. v. Brookfield et al.*, 170 F. R., 946, 955, 38 App. D. C. 528, 34 App. D. C. 491, 177 F. R. 224, 33 App. D. C. 4341, 34 App. D. C. 450, 36 App. D. C. 116, 31 App. D. C. 302, and 33 App. D. C. 490.

We also find the doctrine of *Morgan v. Daniels* announced again by the Circuit Court of Appeals in the second circuit, on a decision rendered February, 1909, *in re Roth et al. v. Harris*, 168 F. R. 279. In this case, referring particularly to the last three paragraphs on page 285, additional testimony was taken in the court, but in a suit for infringement of patent involving interference, the court applied the doctrine of *Morgan v. Daniels*, stating that the case was correctly decided on the interference proceedings and the result would have been the same if the additional testimony found in the record of the suit had been included in the record of the Patent Office.

In this case we wish to point out that the record in the interference proceedings as between the parties to this litigation, involving the invention in issue, was fully twice as ample as the record before the trial judge.

We submit that the authorities and text writers make it plain that not only is the decision of the Patent Office, which has been rendered on behalf of Wilson

in the interference proceedings between Bole and Wilson, and affirmed on appeal, to be considered by this court seriously and with open ear, but unless it should be found that the complainants have not made out a case in this court, which clearly proves the findings of the Patent Office in such decision on priority to be wrong, such Patent Office decision must prevail in this case on our defense under section 4920 and Bole be found not to be the original or prior inventor. How a postal card and the unsupported testimony of the party Bole, in the very face of the estoppel operating against Bole, above referred to, can make out a case seriously to be considered as against the findings of the Patent Office, twice rendered, within a fair application of the doctrine of *Morgan v. Daniels*, is beyond our comprehension. Furthermore, Bole must be found to have surreptitiously or unjustly obtained the patent for that which was never invented by him, but was in fact invented by another, Wilson, who was using reasonable diligence in perfecting and adapting the same. This is all that section 4920 requires.

We have shown that Wilson's diligence was unusual. His reduction to practice commenced within a few days, or within a few hours, of his first proven knowledge of the invention, which was predicated upon his own conception. It is to be understood that the Patent Office not only finds Wilson to be the prior inventor, but the original inventor. That was necessary, because of the allegations of both parties to the interference proceeding, with respect to their disclosures of the invention, each to the other. Upon the theory that each in-

independently produced the invention, so that the question of priority is raised, with the factor of originality conceded for the purpose of presenting a controversy, Bole must be found to lose, as has been decided by the Patent Office, inasmuch as his slightly earlier application will not avail him, because of his lack of diligence, even assuming that he independently produced the invention way back in 1908, as he testifies. Admittedly, he did nothing with the invention from the time of his alleged conception until the filing of the application in 1913, whereas Wilson conceived the invention and entered the field with it in 1911, immediately reducing it to practice, followed by putting it upon the market, and with a disclosure of the invention, with sketches, to others, and Wilson was filling the demand of the market for the invention continuously and uninterruptedly right up to the time he filed his application, twenty-seven days after Bole, and since that time. Bole, on this side of the case, dealing strictly with priority, is to be given but little consideration. Bole cannot prevail under the law as unequivocally pronounced in all the leading decisions.

See section 1024, Robinson on Patents, page 255, volume 3; see *Automatic Weighing Machine Co. v. Pneumatic Scale Corp., Ltd.*, 156 F. R. 288, and particularly the seventh paragraph on page 294 and pages 295 and 296, as to what constitutes a completed invention, the first inventor being he who has put the invention into practice and he only being entitled to a patent. This Bole did not do in any sense. Continuing on pages 296, 297, 298 and 299, it is found that it is an

established rule that drawings in themselves do not constitute an invention, and, unless they are followed up by reasonable observation of the requirements of the patent laws, they cannot have any effect upon a subsequently granted patent to another. See particularly paragraphs 2 and 4 on page 299, in which it is held that it would be a perversion of the purpose of the patent laws if one who had conceived of a new device and proceeded as far as to embody it in sketches, or even in finished drawings, should there stop, and yet hold the field of invention against all comers for a period of years. Many cases are cited, and it is laid down in the second paragraph, page 300, that in a race between two independent inventors, he who first reduces his invention to fixed and positive form would seem to be entitled to the priority and right to a patent therefor. Bole never practiced the invention at all. See particularly the first paragraph on page 301, in which the rule of diligence is stated. The testimony in the case shows that Bole received the knowledge of his invention from Wilson, and afterwards surreptitiously or unjustly obtained his patent, unless the court believes Heber and Adams, and considers the inadmissible, doubtful deposition of Heber. See page 302 as to this. In the present case, of course, we have derivation by Bole from Wilson, and Bole cannot have a valid patent, Wilson being the original inventor, as found by the Patent Office.

On this question of originality, *Loom Co. v. Higgins*, 105 U. S. 580, 594, was a case in which one party was found to have derived the invention from another.

There it is shown that, as in this case, the party charged with derivation did not claim aloud that the invention belonged to himself. This is shown from the testimony of W. W. Wilson, E. C. Wilson and Wilcox, in respect to the disclosure by Wilson to Bole. *Why didn't Bole then and there assert that the invention under consideration was his at this conference of about February 3, 1911, which was too fully established in fact to be less than authentic history; why, if Bole was the inventor of the key issue, did he not at that conference assert such inventorship, rather than merely discuss a useless method of attempting to remove the key from the reamer?*

The Patent Office did not find proper diligence to have been used in Automatic Weighing Machine Co. v. Pneumatic Scale Corporation, Ltd., *supra*, and the court agreed with the conclusions of the Patent Office in this respect. This case goes very fully into the doctrine of diligence and cites a great many authorities. It may be stated to clearly define the law in these particulars, and is a late case, 1909. Further, on this question of diligence, see the following decisions, all announcing the rule above set forth, namely, that where there is a question of priority arising as between two or more inventors, he who is not diligent must lose out in favor of him who takes the field and is diligent, that being strikingly necessary in the present set of circumstances, where Wilson was asserting his claim to the invention and practicing the invention in the very presence of the other party, Bole, while Bole slept at the switch as to any claim he may have had

or thought he had as to this invention. See *Grabowsky v. Gallaher*, 191 O. G. 835; *Watson v. Thomas*, 108 O. G., 1590; *Henderson v. Gilpin*, 187 O. G. 231; *Paul v. Johnson*, 190 O. G. 807; *Paul v. Johnson*, 106 O. G. 2013; *Davis v. Horton*, 136 O. G. 1768. This late case is one in which the junior party had disclosed the invention to several persons and had ordered manufacture of the same prior to the entry of the senior party into the field, and a few months thereafter actually sold a small number, which was followed a few months later by the manufacture and sale of a large number of such devices, the junior party being thus found to be diligent in reduction to practice. These circumstances are almost on all fours with those in the present case on the question of diligence. See also *Woods v. Poor*, 130 O. G. 1313, in which it is held that the nature of the invention, the situation of the inventor, the length of time intervening between conception and reduction to practice, the character and reasonableness of the inventor's testimony and that of his witnesses, are all important factors in determining the question of diligence. These decisions are found in the volumes of Official Gazette of the United States Patent Office, and are, of course, decisions of which this court may take notice, being federal decisions, and particularly in view of the law above set forth, with respect to the effect of decisions of the Patent Office forum upon the federal courts of concurrent jurisdiction.

The situation in the present case shows Bole to have been actuated by animus, inflamed by the co-operation

of Wilson's chief and bitterest competitor in the under-reamer field, the other part owner of the Bole patent in suit.

See also *Lewis & Williams v. Cronmeyer*, 130 O. G. 300; *Lawrence v. Voight*, 147 O. G. 235; *Feinberg v. Cowan*, 125 O. G. 667; *Whitney v. Brewer*, 177 O. G. 1267, in which it was found that the first filing of an application by a party does not preclude the application against him of the doctrine of equitable estoppel, and we contend that Bole is equitably estopped, because of his covenant not to do anything further about the invention, made at the time of the settlement with Wilson and his company, February 1, 1913. In *Schmidt v. Clark*, 138 O. G. 768, it was held that where the evidence fails to show any activity on the part of Schmidt from July, 1903, to December, 1906, when he filed his application, and in the meantime Clark enters the field and gives the public the benefit of his discovery by manufacturing several hundred devices embodying the invention; in order to prevail, Schmidt must prove his case beyond a reasonable doubt. Bole does not prove his case beyond a reasonable doubt, and shows no excuse for his lack of diligence. As to this rule of diligence, it was held in *O'Connell v. Schmidt*, 122 O. G. 2065, that there is no hard and fast rule by which to determine the question of due diligence. In other words, there is no general rule of what constitutes due diligence, that being a question to be determined by all the facts and surrounding circumstances in the particular case.

See also the important case of Garden Supply Co. v. National Washer Co., 176 Fed. Rep. 45, 47.

Further on this question of diligence, see Howell v. Hess, 122 O. G. 2393.

It is pointed out by Robinson on Patents, *supra*, section 1024, on page 38, the plaintiff inventor, although he be proven to be the first conceiver of the invention, may be shown by the defendant to forfeit his right to a patent in favor of a later inventor by his unreasonable delay in its reduction to practice. On this question of diligence, a leading case is Mason v. Hepburn, the decision being of the Court of Appeals of the District of Columbia, in 1898, 84 O. G. 147, particularly the last column of the opinion.

Of course, if Bole derived his invention from Wilson, as we contend, he is not entitled to a patent as issued.

It is significant that we have proven by witnesses that Wilson disclosed the invention to Bole, and that we have only Bole's unsupported statement that he earlier disclosed the invention to Wilson.

And that Bole is not to be believed is proven by the fact that at the time of the disclosure by Wilson to him, namely, the conference of about February 3, 1911, he laid no claim to being the originator of the invention. This man Bole, whose alleged witnesses to the sketch of January 27, 1911, did not ever remember having seen such sketch before they testified; who was contradicted by his friend Willard, and by Wilson, and whose witness Naphas does not know what he is talk-

ing about, is not to be believed himself. It is as plainly to be seen between the lines as though written in red ink, that this claim of Bole's and the harassment of Wilson and the defendant corporation, growing out of such claim, amounted to conspiracy of Bole's and Wilson's competitor, Double, to bring upon the defendants expense, annoyance, trouble and competition.

See *Jenks v. Pagelson*, 184 O. G. 285.

This derivation by Bole from Wilson led to Bole's surreptitious activity in obtaining a patent, within section 4920 of the Revised Statutes. As to Wilson's independence of any such derivation, see *Miller v. Speller*, 165 O. G. 732.

Concealment of an invention is also fatal, coupled with delay in reduction to practice, as per the doctrine in *Mason v. Hepburn*, *supra*; so that, if Bole had the invention before Wilson, his concealment estopped him from properly receiving a patent. See also *Brown v. Campbell*, 201 O. G. 903; *Mathes v. Burt*, 114 O. G. 764; *Quenzer v. Collins*, 179 O. G. 575; *Brown v. Campbell*, 201 O. G. 905; *Baetz v. Kukkuck*, 178 O. G. 887.

As to novelty, we have seen that the same is negated by the making of a single specimen of the patented thing, provided its existence was known in this country prior to the invention by the patentee, even though it was not used prior to that time (see *Walker on Patents*, section 72, page 67, and cases cited), and novelty is negated by prior knowledge and use in this country by even a single person of the thing pat-

ented, provided, of course, that it be a person other than the patentee and independent knowledge (Walker on Patents, section 71, page 66). (See also 46 Ct. Cl., 601.)

This, of course, must be so, under section 4886 of the Revised Statutes, in accordance with which patents for inventions are issued, it being required that the invention must be not known or used by others in this country before the invention or discovery thereof by the patentee. Assuming the acts of Wilson and Bole were independent and neither derived from the other, the making of the first under-reamer embodying the invention by Wilson is sufficient to invalidate the Bole patent, if Bole cannot prove that his invention was made still earlier than that anticipating fact occurred. This has nothing to do with the question of originality, as between Wilson and Bole, or of priority, as between Wilson and Bole, but is that other defense, namely, of anticipation by Wilson's manufacture, sale and use of Wilson reamers; and where, as in this case, we have proven manufacture and sale prior to Bole's date of application, the *burden is shifted to the appellees* to prove by convincing preponderance of evidence that Bole's invention was still earlier than that manufacture and sale took place. As to burden of proof in this respect. see also Eastern Paper Bag Co. v. Continental Paper Bag Co., 142 F. R. 501. If the plaintiff does not introduce enough evidence to outweigh whatever evidence is introduced to the contrary, the patent must be void for want of novelty. Walker on Patents,

section 76, last paragraph, page 71, and the cases cited therein.

Now, as to this defense, it is contended that Bole has not established possession of the invention prior to the disclosure of the same to him by Wilson, and likewise the patent is therefore anticipated by this Wilson manufacture, and must be found invalid.

There are, therefore, three burdens resting upon Bole, one to establish originality, one to establish priority, and one to establish possession of the invention prior both to the disclosure of the invention to him by Wilson and prior to the Wilson manufacture and sale of the invention. As to originality, we contend that all of the facts and circumstances in the case are against him. As to priority, he must lose because of his lack of diligence, and as for his being in possession of the invention earlier than Wilson disclosed it to him, or Wilson commenced to manufacture, the gravest doubt is raised because of the circumstances of the case, and Bole's failure to speak out when Wilson commenced to assert his invention. This very failure likewise, with the other circumstances of the case, renders it unbelievable that Bole ever was in possession of the invention before he obtained the knowledge of the same from Wilson.

THREE CHIEF DEFENSES, AND EACH SUFFICIENT TO REVERSE THE LOWER COURT.

Thus we contend that appellants have prevailed upon these three defenses, that of want of originality in Bole, that of want of priority in Bole, and that of want of

novelty in the Bole patent. And in addition to that we have Bole barred by estoppel attaching to his covenant in favor of Wilson and his company.

See in this connection, upon the question of burden of proof, *Clark Thread Co. v. Willamantic Linen Co.*, 140 U. S. 492; also 52 F. R. 760; 108 F. R. 221; 121 F. R. 53; 11 F. R. 155; and 20 F. R. 693.

BURDEN OF PROOF SHIFTED TO APPELLEES.

The anticipatory fact consisting of manufacture and sale by Wilson of reamers embodying the invention prior to Bole's date of application absolutely shifts the entire burden of proof to Bole, and, therefore, on all the questions in this case, of originality, priority and of possession of the invention prior to Wilson's practice thereof, we must look to the appellees to make out their case beyond a reasonable doubt. They utterly have failed to make out any case of diligence with respect to priority, or to make any affirmative conclusive showing of originality, or to make any affirmative conclusive showing as to possession of the invention prior to the anticipatory act of Wilson manufacture. The laches of Bole are against him on all of these questions.

See also, on the question of novelty, 22 F. R. 650, 82 F. R. 1897.

That Bole applied for patents on other inventions and delayed in applying on the key invention is competent evidence against his claim of invention, as in *Frink v. Petry*, 11 Blatchford, 1 Bann. and A 1.

That inference may be drawn by the court from the conduct of Bole which may outweigh direct testimony of any number of witnesses, see telephone cases, 126 U. S. 1.

That the commissioner of patents has judicial functions, of which the courts may take judicial notice, see *Butterworth v. U. S.* 112 U. S. 656, page 662, first column.

The question, of course, of want of novelty as defeating the Bole issued patent, was not for the Patent Office, as they could not cancel the patent, and that is an added defense in this suit, which makes Wilson's case even stronger than it was in the Patent Office, inasmuch as *the burden of proof is shifted by the anticipatory fact of Wilson's earlier manufacture to the appellees, and they must make out their case beyond a reasonable doubt.*

Bole cannot prevail on the score of priority of invention due to his total want of diligence, and he cannot prevail on the score of originality on his own unsupported word, with this burden of proof against him. Nor, in spite of all the circumstances, can he prevail on the ancient history of the 1908 legend with Adams' support, or by the improper deposition of Heber, with this burden of proof against him and the priority findings against him, such question of anticipatory use in this case being inseparably intertwined with the question of priority, and such anticipatory facts being part of Wilson's proofs of priority. So that Heber and Adams can be of no avail to Bole on priority, and, of

course, not on originality, and, likewise, not with respect to the anticipatory fact of Wilson's earlier manufacture and sale. At every angle of the case Bole is met with the closed door of laches, concealment, and estoppel, and with the fatal stabs of contradiction, want of corroboration, animus and improper motive.

The proofs in this case, more effectively than those possible before the Patent Office, make Wilson out the original and prior inventor of the subject of the patent in suit and make that patent out, therefore, invalid, and, likewise, and further, invalid because of the anticipatory manufacture and sale by Wilson of the reamers embodying the invention.

With all these facts and the law in connection therewith against the appellees, including the doctrine of *Morgan v. Daniels*, *supra*, and the persuasive effect of the findings of the Patent Office upon this court, it is contended that the appellees cannot prevail, because, and only because, of the unsupported, contradicted and discredited word of the appellee Bole plus his 1908 postal card.

The patent in suit should be found invalid upon the law and facts above set forth, and, therefore, upon the facts above presented, together with the remainder of the record in the case and the law as it stands pertinent to such record and facts, and the valid conclusions to be drawn from the record in such case, this case is respectfully submitted, with confident solicitation that the decree of the lower court be reversed in each and every respect.

Respectfully submitted,

RAYMOND IVES BLAKESLEE,

Solicitor and Counsel for Appellants.

